

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:)
F.L. Conte)
) Art Unit: 3643
)
Application No.: 10/643,288)
Confirmation No: 4031) Examiner: Rowan, K.
)
Filed: 08/20/2003)

Title: Duplex Lash Insect Swatter

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
SECOND APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR 41.31, Appellant hereby appeals to the Board of Patent Appeals and Interferences from the final decision of the examiner dated 02/07/2007, finally rejecting claims 1, 3, 5, 6, and 8-23.

In accordance with 37 CFR 41.37, Appellant hereby submits this Appeal Brief and requests that the final rejection of the claims be reversed and that these claims be allowed.

The Notice of Appeal PTO/SB/31 is being filed concurrently herewith.

REAL PARTY IN INTEREST

The real party in interest is Francis L. Conte.

RELATED APPEALS AND INTERFERENCES

The subject application discloses and claims improvements made to the insect swatter disclosed and claimed in application Ser. No. 08/331,851 which was filed on 10/31/1994; and issued as US Patent 6851218 on 02/08/2005.

In that parent case, two appeals were decided by the BPAI in Appeal No. 96-3971 and Appeal No. 2000-2033 reversing rejections made by the present examiner. And, in Appeal No. 02-1150 to the CAFC, a Judgment affirming certain rejections was entered on 06/05/2002.

In the present application, a first Appeal, No. 2006-0635, resulted in a full reversal of the previous final rejections in a BPAI decision dated 03/09/2006.

STATUS OF CLAIMS

Claims 1, 3, 5, 6, and 8-23 stand pending in the application.

Claims 2, 4, and 7 stand canceled, without prejudice.

No claims stand withdrawn.

No claims stand objected to.

No claims stand allowed.

Claims 1, 3, 5, 6, and 8-23 stand finally rejected and are the subject of this Appeal Brief.

STATUS OF AMENDMENTS

There is no amendment filed subsequent to the final rejection.

BACKGROUND

In the first appeal decision in this application reversing, yet again, the same examiner Rowan, the BPAI politely pointed to the continual fallacy in the examiner's continued rejections by noting that "the rather imaginative rationale advanced by the examiner to account for the acknowledged deficiencies of [the applied reference ...] amounts to no more than unsupported conjecture."

"Rather imaginative rationale" of this examiner has been repeated time and time again, and yet again in the latest final rejection, without any regard to the BPAI and its precedent in the parent application, and now this improvement application.

Not once has the examiner taken any guidance from the three previous BPAI decisions in which the examiner has been repeatedly reversed in this ever longer journey before the USPTO in obtaining a patent for the latest improvement of the recited insect swatter.

The typical insect swatter, commonly referred to as a fly swatter, has a long handle with a proximal end configured for being gripped by a person, and a distal end at which is secured a generally rectangular, perforated wire or plastic mesh. In operation, the swatter is manually moved through the air for striking the insect with the mesh.

However, the swatter must be moved very quickly in order to swat fast-reacting flies for example, or the fly will escape. The relatively large swatter mesh is apparently detectable by the insect either through its vision or by sensing the air being displaced as the mesh is moved.

If the swatter is moved quickly enough, the insect can be stricken which typically results in an offensive stain being created upon squashing of the insect.

An improved insect swatter is disclosed in the parent

U.S. patent application Serial No. 08/331,851, filed 10/31/1994, now US Patent 6851218. That insect swatter utilizes a long rubber band attached to the distal end of a long gun barrel or rod that can be stretched to a trigger latch at the opposite end of the rod at a handgrip.

Since the lash is elastic, it is able to store energy when stretched, and release that energy against the insect when it contracts during the whipping process. The elasticity of the lash also affects the effective striking range of the lash.

Continued development testing of the insect swatter has examined the effectiveness of the swatter, and uncovered problems therewith.

For example, short and stiff elastic lashes are not preferred since they have limited range and limited, if not impractical, ability to swat insects before detection. Long and resilient elastic lashes, on the other hand, have greater striking range, yet less available swatting energy, and are significantly weaker.

Furthermore, weak elastic lashes are more readily worn or damaged than strong lashes, and more quickly lose their swatting effectiveness. The typical rubber composition used in commercially available rubber bands is subject to environmental degradation which reduces the resiliency or stiffness of the bands, and the effectiveness thereof.

In view of these competing affects it is not practical to optimize elastic lash selection by merely choosing a band length and cross section for the specific size of the intended rod. And, custom made bands merely add to the cost of the swatter, and reduce the convenience thereof.

These problems have been solved in the improved insect swatter of the subject application; yet the examiner's repeated rejections fail to afford any weight thereto in complete disregard to the "whole" invention as recited in the various claims, and as described in the specification.

SUMMARY OF CLAIMED SUBJECT MATTER

The claims on appeal include three independent claims 1, 17, and 21.

Claim 1 recites an insect swatter 10 shown for example in figures 1 and 6. The swatter includes an elongate rod 12 having a proximal end 12a for being hand-held, and an opposite distal end 12b for being aimed at an insect as disclosed at page 3, ll. 13-23.

Cooperating with the rod is an elastic lash 34 including only a pair of identical annular rubber bands 36,38 joined together at a knot 40 therebetween, and having a proximal end 18a fixedly joined and retained to the rod distal end 12b, and an opposite and loose distal end 18b sized for being elastically stretched from the rod distal end 12b to adjacent the rod proximal end 12a so that release of the lash distal end 18b spontaneously contracts the lash 34 for whipping the lash distal end 18b in extended striking range against the insect while the lash 34 is retained at the rod distal end 12b without disconnection therefrom.

Figures 1, 2, and 4 illustrate the lash 18 in its original single-band form as patented in the parent application; and figures 5 and 6 illustrate the improved duplex lash 34 as recited in the present claims. The duplex lash 34 is introduced at page 9, line 29 through page 10, line 20; with additional reference to its substitution for the single-band lash 18 as further disclosed at page 3, line 24 through page 4, line 2, for example.

Independent claim 17 recites an insect swatter 10 including the elongate rod 12 having a slot 30 at a distal end 12b thereof; an elastic lash 34 configured in a figure eight with first and second knot-less loops 36,38 at opposite ends, and joined together at a knot 40 therebetween; and the

lash first loop 36 is fixedly retained in the slot 30 to prevent disconnection therefrom when the lash 34 is whipped along the rod 12..

Claim 17 shares common features with the claim 1 swatter as disclosed in the specification as indicated above, and specifically shown in figures 5 and 6.

The specific figure-eight (8) form of the lash 34 is disclosed at page 10, 11. 1-20.

Claim 21 recites an insect swatter including an elongate rod 12 having a proximal end 12a, and an opposite distal end 12b for being aimed at an insect and including a keyhole slot 30.

A gun handgrip 14 is fixedly joined to the rod proximal end 12a, and a latch 20 is pivotally joined to the handgrip 14 adjacent to the rod proximal end 12a.

Means 24, 20b are recited for selectively releasing the latch 20 and include a trigger 24 operatively joined to the latch 20 for releasing the latch 20 upon pulling the trigger 24.

An elastic lash 34 includes first and second annular rubber bands 36, 38 knotted together at an intertwined knot 40 therebetween. The first band 36 has a proximal end 18a forming a lash first loop 36 disposed through the keyhole slot 30 for fixedly retaining the lash 34 to the rod distal end 12b.

The second band 38 has an opposite distal end 18b forming a lash second loop 38 positionable around the latch 20 for being releasably retained thereby.

The lash 34 is sized for being elastically stretched from the keyhole slot 30 to the latch 20 so that release of the second loop 38 from the latch 20 spontaneously contracts the lash 34 for swatting the second loop 38 against the insect.

Claim 21 shares the same description in the specification and the figures as presented above for claims 1

and 17.

Claims 3, 5, & 21 specifically recite means 24,20b for selectively releasing the latch 20, which means are disclosed in the specification at page 5, line 23 through page 6, line 17, and include the trigger 24 and the cooperating latch cam 20b joined to the latch 20 shown in figures 2 and 3.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Ground (1) - whether claims 1, 3, 5, 6, 8, 10-14, and 17-23 are unpatentable under 35 USC 103(a) over U.S. Patent 1,779,507-White and U.S. Patent 2,642,057- Watkins.

Ground (2) - whether claim 9 is unpatentable under 35 USC 103(a) over U.S. Patent 1,779,507-White, U.S. Patent 2,642,057- Watkins, and U.S. Patent 102,594-Robinson.

Ground (3) - whether claims 1, 3, 5, 6, 8, and 10-23 are unpatentable under 35 USC 103(a) over U.S. Patent 2,642,057- Watkins and U.S. Patent 1,779,507-White.

ARGUMENT

It is noted that the parent application required a literal 10-year odyssey to issue as a patent due in most part to the examiner's continued failure to afford due weight to Appellant's claimed invention which is evidence of well proven bias against the invention, both in the parent, and now in the present improvement invention.

The examiner has repeatedly shown that he will proffer any argument to reject all the claims, and has continually deferred to the Board to objectively review the claims de novo, and let only Board decision result in allowed claims.

The continued abuse of process by the examiner, and continued failure of the examiner to afford any deference to even previous decisions of this Board is now well substantiated by the lengthy file history.

The present examiner is the same examiner who handled the parent application, and this examiner has not yet allowed even one claim in the parent or this improvement application, with the parent being allowed to issue only by successful appeal to the BPAI, not once, but twice.

And, yet again, this Appellant is required to appeal to this Board for another, second time. Will these incessant appeals never end?

The Board represents the PTO, and as such the Board is inclined to sustain examiner rejections; and, perhaps, this examiner expects that this fourth appeal to the BPAI will finally result in a favorable ruling for the examiner, at the continued expense of the Appellant.

Patent Rule 104 is reproduced in part as follows:

(a) Examiner's action.

(1) On taking up an application for examination

or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters
....

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The parent application has undergone inordinate scrutiny by the Patent Office, including two appeals.

The present, improvement application is unfortunately following the same history, including now (at least) two appeals as well.

It is quite clear that Rule 104 has been violated in the re-opening of prosecution following the full reversal of the initial final rejection.

How is it possible that the examiner in the twelve years of prosecution of these applications has failed to previously uncover the "newly uncovered" references White and Robinson?

The examiner has available the full resources of the PTO, including modern computer searching, yet the new

references were not previously cited and applied?

Why?

Perhaps because the examiner continues to proffer rote rejections and will just not allow any claim, any claim, due to now well substantiated bias against the clearly simple insect swatter invention.

The newly applied references clearly teach away from the present improvement claims, yet the examiner has shown his mastery of patent examination in fabricating rejection after rejection, without regard to merit.

And now, the examiner has even obtained the imprimatur of the Director himself to reopen prosecution and re-reject the claims, yet again without regard to merit, and, indeed, without any regard to the latest amendment of the claims, and the additional new claims, completely overlooked by the examiner in the expedient rush to reject all claims.

The parent application has now issued in a U.S. patent, and the improvement claims are similarly entitled to patent issuance not only on their own merits, but for the merits of the common features found therein from the parent.

Yet, the examiner affords no weight to either those previous common features, nor the previous three decisions on appeal, nor to the improvement features, and yet again requires a fourth Board of Appeals to now decide de novo the patentability of the improvement claims.

Ground 1

Ground (1) - whether claims 1, 3, 5, 6, 8, 10-14, and 17-23 are unpatentable under 35 USC 103(a) over U.S. Patent 1,779,507-White and U.S. Patent 2,642,057- Watkins.

Appellant traverses this rejection of the claims, and requests reversal thereof.

Firstly, neither White nor Watkins is analogous art.

Applicant's field of endeavor, as expressly recited in

the claims, is an insect swatter; and the toy guns of both White and Watkins are clearly not insect swatters.

Applicant's problems are expressly listed in the specification and include striking range; striking energy; weak, worn, damaged, and degraded lashes; and custom made bands having no counterpart in either White or Watkins, which, instead have different problems.

At page 8 of the final office action, the examiner cites In re Oetiker without any regard thereto and without any analysis whatsoever. The examiner merely concludes that "In this case, White and Watkins are reasonably pertinent to the particular problem with which applicant was concerned."

But, what problem is that?

Why has the examiner failed to identify any problems in White and Watkins which match Appellant's stated problems?

Because White and Watkins are just not relevant to Appellant's stated problems, or to each other because the two toy guns thereof are differently configured from each other, differently used, and apparently address different problems.

Col. 1 of White expressly states the object of a simple device to discharge and catapult away an elastic band. How is this "pertinent" to Appellant's stated problems for which the lash must not be catapulted away?

The examiner has failed to explain.

Col. 1 of Watkins fundamentally teaches a toy gun for shooting small projectiles; yet again having no pertinence to Appellant's stated problems for which the lash must not be shot away.

The examiner has again failed to explain.

And, the rote conclusion of "pertinence" and silence on details proffered by the examiner are quite telling of the continued bias against patentability by the examiner who appears to have lost any objectivity in applying the art to the improvement claims.

The two references, White and Watkins, are therefore

nonanalogous art are and fail to provide any evidentiary basis to reject any claim under Section 103.

MPEP 706.02(j) provides the basic requirements which must be provided by the examiner in establishing prima facie obviousness under 35 U.S.C. 103. Four steps are required of the examiner including:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Citing Ex Parte Clapp, the MPEP places the burden of proof on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly

or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

It is the examiner who must meet this initial burden by applying specific evidence; and clearly the examiner has not met this burden with the unsupported rote conclusions of obviousness, which fail to meet the stringent "legal motivation" requirements of MPEP ch. 2100.

Indeed, at page 8 the examiner cites *In re McLaughlin* to support "hindsight reconstruction," but "so long as it takes into account only knowledge which was within the level of ordinary skill"

Yet again, another rote application by the examiner of case law without the requisite showing of similar facts, and without any showing whatsoever of specific evidence and legal motivation from the references being applied.

Recall from the first appeal that the Board noted the "rather imaginative rationale" of the examiner, and yet, that rather imaginative rationale continues unabated, and with complete disregard of the stringent standards under the MPEP and case law cited therein.

CLAIM 1

1. An insect swatter 10 comprising:
an elongate rod 12 having a proximal end 12a for being hand-held, and an opposite distal end 12b for being aimed at an insect; and
an elastic lash 34 including only a pair of identical annular rubber bands 36,38 joined together at a knot 40 therebetween, and having a proximal end 18a fixedly joined and retained to said rod distal end 12b, and an opposite and loose distal end 18b sized for being elastically stretched from said rod distal end 12b to adjacent said rod proximal end 12a so that release of said lash distal end 18b spontaneously contracts said lash 34 for whipping said lash distal end 18b in extended striking range against said insect while said lash 34 is retained at said rod distal end

12b without disconnection therefrom.

It is noted that the examiner first applied to claim 1 the White reference under Section 102, and that rejection was overcome; as expressly admitted by the examiner in para. 4.

Nevertheless, the examiner has used the expedient of the word processor to copy, verbatim, his Section 102 contentions for White as previously presented in para. 2 of the 8/30/06 office action reopening prosecution following the first appeal, now into para. 2 of the final office action, notwithstanding the fundamental shortcomings of White.

The examiner's contentions in para. 2 lack merit and are erroneous, and fail to meet the stringent requirements for claim interpretation for identity of structure, cooperation, function, and purpose.

Claim 1 recites an insect swatter, and White discloses only a toy gun.

The examiner's attempt to qualify his interpretation of the claim 1 lash "proximal end fixedly joined to said rod distal end" fails to afford due weight to the entire claim, and is evidence in and of itself that White is inapposite since claim 1 does not include the same qualification proffered by the examiner.

Claim 1 does not recite the qualified fixed attachment "until the swatter's trigger is pulled" as the examiner contends, but recites the fixed attachment unqualified in accordance with ordinary English definition and as used in the specification.

The common dictionary definition of "fixed" means firmly attached and not movable; remaining in the same position; and even, persisting obstinately.

The examiner's use of Figure 1 of White is erroneous, since claim 1 is directed to Appellant's Figure 1 in which the lash is attached solely to the rod distal end and is expressly too short to reach the latch.

In other words, claim 1 recites the "uncocked" lash and swatter, whereas the examiner is applying Figure 1 of White for the "cocked" bands and gun.

To be certain, in the uncocked state of Figure 1 in White it would be impossible to "attach" in any way the 3-bands to either the extension 10 or the sight 4 because the 3-bands are merely the loose work product (ammunition) and do not form an integral part of the toy gun itself.

Claim 1 also recites that the lash is fixedly attached even after the lash is spontaneously contracted; yet when the bands in White are fired, they are propelled in toto, and cannot be fixedly attached. Instead, they are merely "releasably" resting on the toy in a distinction provided no weight by the examiner.

And, claim 1 further recites the fixed attachment of the lash to ensure that only the "lash distal end [is swatted] against said insect."

Note in this regard, that the lash recited in claim 1 has a "proximal" end and a "distal" end for which the examiner has afforded no weight.

The ordinary definition of proximal is nearest the point of attachment of an object; and the ordinary definition of distal is farthest or opposite to the point of attachment.

In claim 1 the recited lash 34 is attached at its proximal end to the distal end of the rod 12, and the lash is expressly shorter than the rod so that it can be elastically stretched to position the lash distal end at the rod proximal end when used.

In White, the 3-bands have no analogous proximal and distal ends since the bands are not fixedly attached to the toy at either end, and the 3-bands are already stretched to rest on the opposite ends of the toy, in a configuration that cannot match the recited structure of claim 1 which does not recite that the lash is already stretched and mounted on the rod as discussed above.

The fundamentally different configuration in White is necessary therein in order to project or catapult or hurl the entire three-bands far away from the toy as expressly taught by White.

Those three bands include a left band in figures 1 & 2 having a left end temporarily resting on the extension 10, a middle band, and a right band having a right end resting temporarily on the sight 4, and only after the gun is loaded, not before.

Note that the left and right ends in White do not qualify as proximal, or even distal, since they are intentionally not fixedly attached to the toy in order that they may be liberated therefrom.

Assuming arguendo that hurling of the 3-bands is contemplated toward an insect then it is more likely than not that the right end of the 3-bands, not the left end, would first reach that insect; and even then either that right end would hit that insect or the middle and right bands would hit that insect before the left band could; but this is pure speculation, which Section 103 does not condone, and the examiner has not shown otherwise.

At para. 4 the examiner attempts to further explain his rejection.

The examiner contends that "Applicant argues that White does not show that the lash is fixed;" but the examiner distorts the facts.

The examiner himself in para. 2 has repeatedly stated that White shows the "proximal end fixedly joined to the rod distal end 4 ...," which is not supported by the evidence therein.

Now, in para. 4 the examiner disavows this contention by instead stating that "clearly Watkins shows the lash fixed to an end of toy gun in inclined slot 34."

The examiner did not argue this combination before.

The examiner is applying a Section 103 rejection, and

has overlooked his expedient in copying the Section 102 arguments he previously made, and, perhaps, now disavows?

If White were modified by this latest fabrication by the examiner to include the slot 34 from Watkins in substitution for the sight 4, then just as "clearly" the 3-bands in White would be prevented from being shot away, rendering inoperative the toy gun of White for its "intended use."

The Federal Circuit in *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984) held that:

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

Furthermore, the Federal Circuit also reasoned that if an apparatus were rendered inoperable for its intended purpose in view of the proposed modification by the PTO, this is an indication that the reference teaches away.

The examiner has therefore been trapped in his own inconsistent arguments. If the 3-bands in White are not fixed to the sight 4, the gun lacks pertinence to claim 1. If the examiner now combines the slot 34 fixed connection from Watkins for the sight 4 in White, the toy gun in White is rendered inoperable against the very teachings thereof to catapult away the bands.

Which argument should the examiner, and now the Board support, if any?

How about yet another argument to consider, the examiner additionally presents in para. 4.

The examiner alternatively contends that "... the rubber bands [of White] can be thought of as being fixed on the gun."

Where is any case law that merely being "thought of" provides any basis to reject under Section 103?

One impossible hurdle after another does the examiner

proffer to prevent the allowance of any claim in this application.

And, most significant is the fact that claim 1 was amended to additionally overcome these mere examiner arguments; yet the examiner has not addressed those very amendments in the verbatim copying of the previous remarks, or in the new "Response to Arguments" section found in para. 4.

Claim 1 now recites the identical pair of bands 36,38 with fixed proximal end 18a which is retained even after whipping, and the loose distal end 18b which does the whipping under extended striking range. See paras. 21, 23, 25, 26, 42, 44, and 65 for example.

Since the examiner has failed to address amended claim 1, the rejection thereof cannot be sustained.

Perhaps in para. 4, the examiner is denying any weight to the amendment as mere "intended use?"

But, the examiner has no problem with applying White for its "intended use," and even distorting that intended use by baldly stating that "White shows structure capable of performing the applicant's intended use of the present invention."

And, what structure is that, and what intended use?

The "structure" in White is specifically configured to catapult away the 3-bands. The "use" therefore is projectile liberation.

In claim 1, the lash is fixedly joined to the rod to expressly prevent liberation of the lash, and, instead, form a whip in which the lash is "used" like a whip, not like a gun.

What then is the evidentiary and legal bases to support these gross distortions being proffered by the examiner?

The more the examiner argues, the more distorted those arguments become.

To be certain, Appellant's invention is simple.

The toy gun in White is simple.

And, the toy gun in Watkins is simple.

Yet, despite this well apparent simplicity, the examiner is unable to fabricate a consistent and cogent rejection, because the simple facts just do not support rejection.

White and Watkins disclose toy guns fundamentally different from each other, and Appellant's claims recite an insect swatter fundamentally different from those two toy guns.

It is only the examiner, with his considerable experience before the PTO, who in conspicuous hindsight can fabricate rejection after refection for reason after reason, all without due regard for the stringent requirements under the MPEP.

Indeed, the examiner even cites McLaughlin for legal support, clearly without any regard to the facts or holdings thereof, and only because that case is found in the "hornbook" listing thereof in the MPEP.

Amended claim 1 emphasizes the whip construction of the swatter because the lash 34 has a proximal end 18a fixedly joined and retained to the rod distal end 12b, while the opposite lash distal end 18b is loose and sized to be stretched to reach the rod proximal end 12a.

No such teaching is found in White or Watkins, and the examiner has not shown otherwise.

At para. 4, the examiner simply states that "White has one end which can be considered as the proximal end and the other end can be considered as the distal end."

But, what does this bald statement mean, and what elements is it relevant to, and how is this relevant to claim 1?

Claim 1 recites different ends for the different rod and lash, clearly overlooked by the examiner.

And, the examiner has afforded no weight, let alone due

weight, to the combination of elements recited in claim 1.

How is either end of the 3-bands in White loose on the sight 4 or extension 10?

How is either end fixed?

If the 3-bands were removed from the gun in White, clearly they would be much shorter in unstretched length, and then neither end could in fact be fixed to either the sight 4 or the extension 10, but the examiner disregards this fundamental fact.

Claim 1 also recites only a pair of identical bands; yet again overlooked by the examiner.

In White three (3) bands are joined together, not two.

Although col. 2, l. 87, mentions one, two, or three, there is no teaching of using two identical bands fixed at one end and loose at the other.

Figures 1 and 2 clearly show three different length bands, which cannot be identical.

At page 8, the examiner merely argues that "patent drawings are not to scale," but this is not relevant because the examiner, not the Appellant, has the burden to support the rejection under Section 103, and the examiner cannot meet that burden by mere speculation, or attempting to reverse the burden of proof.

To be certain, had the figures of White shown equal length bands, the examiner would certainly have so stated.

But because the figures of White do not show equal lengths, the examiner is constrained to argue only, and examiner argument is never evidence, nor can it meet the stringent requirements under Section 103.

What does the MPEP provide in this regard?

MPEP 2125 clearly states that the drawings of a reference can be used for what they reasonably disclose when read in light of the description.

The figures in White may not be drawn to any scale, but scale is irrelevant to the features clearly illustrated

therein.

Figures 1 & 2 of White clearly show three different length bands on the toy gun, and the scale of the bands and gun is irrelevant except that the bands are sufficiently long to be mounted as shown in the relative sizes indeed shown.

At col. 1. ll. 19+, White expressly states that the "elastic bands [may be] formed of old inner tire tubes."

But, how would that be done?

Would the artisan simply take a pair of conventional scissors and start cutting out bands?

And if so, the resulting bands would clearly not be identical, nor would they necessarily have the same size and length due to the practical impossibility of dissecting the old inner tire tube.

The identical bands recited in claim 1 have specific benefit as well disclosed in the specification.

One considerable benefit is to avoid custom fabrication while achieving improved performance.

Cutting old tires is clear custom construction, with attendant problems; and old cut tires would clearly lack the efficacy of the identical bands.

But, why should the examiner afford any weight to Appellant's claims?

No, the examiner affords no weight whatsoever; and at page 8 simply contends that "clearly those [old inner tire] tubes could be considered in 1930 to be identical since quality control is likely to be better now than then."

What does that bald fabrication mean?

"Identical 1930 tubes?"

It is not the tubes which must be identical, but the pieces cut therefrom.

Perhaps, the examiner is interpreting that White teaches the use of three old inner tubes for the three bands in the figures?

But, scale or no scale, where is such construction

evident from the figures in White?

Those 1930 tubes would have to be quite small to be assembled together in the 3-bands illustrated; and what 1930 vehicle would have such small tubes?

Appellant's interpretation of White is just as much subject to speculation as the examiner's, but Appellant does not have the burden of proof.

It would appear that the 1930's tubes would be cut up to form the 3-bands, and how that is done is anyone's guess, but guessing is not allowed under Section 103.

And, the examiner has even cited Mclaughlin at page 8 for the holding of using "only knowledge which was within the level of ordinary skill," but the examiner has failed to provide any evidence of that knowledge, including any evidence for the actual size of the 3-bands.

In para. 2 the examiner admits that "White does not show a keyhole slot, but uses the front sight to attach the rubber bands."

Next, the examiner then attempts to combine Watkins for the slot 34, and indeed the examiner references claim "7," but claim 7 has been canceled.

Since the examiner has used the expedient of copying the previous rejections from the last office action and rearranging them in the different paragraph rejections in the final office action, the examiner has been trapped in his own rote rejection of the various claims, with the inherent failure to consider the claims de novo, especially the amendments thereto.

This superficial record of examination poisons each and every claim rejection since the examiner has chosen to merely repeat previous rejections, and recast them as new, when, to the contrary, the rejections are old, and the amended claims have not been afforded due weight as mandated by both the MPEP and case law.

In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed.

Cir. 1999), is one of many cases that emphasize the evidentiary showing required by the USPTO in supporting an obviousness rejection for avoiding impermissible hindsight. The USPTO rejected as obvious claims for a trash bag colored orange in imitation of a pumpkin and decorative face for Halloween. The USPTO cited many references for creating Jack-O-Lantern bags, including conventional plastic lawn or trash bags. The Federal Circuit reversed the obviousness rejections as hindsight-based, and summarized previous cases:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.... [In re Rouffet] "the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." [In re Fritch] examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]." [In re Fine] evidence of teaching or suggestion "essential" to avoid hindsight. [Ashland Oil] district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination." [Graham] "strict observance" of factual predicates to obviousness conclusion required. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --- the essence of hindsight. [Interconnect Planning Corp.] "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.... although "the suggestion more often comes from the teachings of the pertinent references...." The range of sources available, however, does not diminish the *REQUIREMENT FOR ACTUAL EVIDENCE*. *THAT IS, THE SHOWING MUST BE*

CLEAR AND PARTICULAR.... Broad conclusory statements regarding the teaching of multiple references, standing alone are not "evidence...." In addition to demonstrating the propriety of an obviousness analysis, *PARTICULAR FACTUAL FINDINGS REGARDING THE SUGGESTION, TEACHING, OR MOTIVATION TO COMBINE* serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references....

Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific - or even inferential - findings concerning the identification of the relevant art, the nature of the *PROBLEM* to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references *CAN* be combined to read on the claimed invention. For example, the Board... concludes that the *SUBSTITUTION* of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an *OBVIOUS DESIGN CHOICE*... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate *HOW* the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See Rouffet... noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle... would have suggested the combination." Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. [emphasis added]

The examiner has expressly withdrawn the rejections of claims 1-6 under Section 102 over White, but in merely repeating the grounds therefor in para. 2 under Section 103, the examiner has failed to present any basis to reject

amended claim 1 under Section 103 in combination with Watkins.

It appears from para. 4 that the examiner intends to combine Watkins and White by substituting the slot 34 of Watkins for the sight 4 in White in order to affix the 3-bands in White in meeting the recitation in claim 1.

However, Dembiczak provides the basic requirements for evidence and legal motivation in combining references, which the examiner has failed to provide in the combination of White and Watkins.

And, to the contrary, the proposed combination of Watkins and White to affix the 3-bands at the sight 4 in White by substitution of the slot 34 from Watkins would clearly render inoperable for its intended purpose the 3-band shooter of White in which those bands must be catapulted away, and must not remain affixed to the gun.

This, the examiner must overlook for various reasons including mere "intended use," but without regard to the actual recitations in the claims, including claim 1.

The two toy guns in White and Watkins could not be any more different from each other, and similar only in their different configurations for shooting projectiles; in White, the 3-bands themselves, and in Watkins the pea.

Of course, the examiner can, and has, presented myriad reasons to combine various references to reject claims, that is what he is trained to do. See, for another example, the reverse use of Watkins and White presented in the para. "3" at page 5 of the office action.

And, also note that due to the examiner's haste in repeating and reconfiguring the rejections, he has even incorrectly numbered the paragraphs [1, 2, 5, 3, 4, 5] based on the paragraphs in the previous office action.

The examiner's haste has unduly increased the difficulty of addressing his various rejections and various remarks, and now it is up to the Board, de novo, to decipher

the examiner's intentions in rejecting the various claims.

The new para. 2 of the office action newly lists claims 1, 3, 5, and 6, previously rejected under Section 102, but now withdrawn, and since the examiner has merely copied the White description, he has failed to address claims 3, 5, and 6 under Section 103; instead starting with claims "1, 7, and 17-20, 21" at page 3 of the office action.

CLAIM 3

3. A swatter 10 according to claim 1 further comprising:

a latch 20 pivotally joined adjacent to said rod proximal end 12a for releasably latching said lash distal end 18b; and

means 24,20b for selectively releasing said latch 20 to release said lash distal end 18b for swatting said insect therewith.

Claim 3 further recites the latch 20 and cooperating releasing means 24,20b, which both further cooperate with the lash being fixedly joined to the distal end of the rod in a combination yet again overlooked by the examiner in his rush to reject the claims.

In White, the extension 10 not only releases the 3-bands, but cooperates with the sight 4 to hurl the entire 3-bands toward an object with no efficacy to limit that hurling for specifically swatting the left end of the 3-bands at the object.

The opposite right end of the 3-bands at the sight 4 would most likely precede in flight the left end at the extension 10, and render quite impossible the ability to strike the object with that left end. And, the examiner has not shown otherwise in his rush to reject.

Indeed, the examiner has failed to present any reasons to reject this claim under Section 103.

CLAIM 5

5. A swatter 10 according to claim 3 further comprising:
a gun handgrip 14 fixedly joined to said rod proximal end 12a;
said latch 20 being pivotally joined to said handgrip 14; and
wherein said latch 20 releasing means 24,20b includes a trigger 24 operatively joined to said latch 20 for releasing said latch 20 upon pulling said trigger 24.

Claim 5, like claim 3, recites the cooperation of the latch 20 and its releasing means 24,20b in the gun handgrip in a combination clearly not disclosed or suggested by White and Watkins for the same reasons presented above.

The examiner has failed to show any evidence in White that the left end of the 3-bands resting at the extension 10 could in fact be used to reach and swat an insect without regard to the remainder of that 3-bands which has most mass, most inertia, and would most likely precede the left end of the 3-bands in free flight from the toy gun.

The combination by the examiner with Watkins further teaches away from this claim because Watkins expressly teaches a different finger hold 28 having no connection with the pin 18 for releasing the band 14.

Of course, the examiner must necessarily select only naked elements from Watkins to combine with White, because hindsight so mandates; but without Appellant's claims as the guide, the examiner, and one skilled in the art would not know what to select and what not to select from the disparate references.

It is well evident that the two toy guns are quite different from each other, and without Appellant's claims, one skilled in the art would have no reason to combine the different features of the different references in any way relevant to Appellant's claims.

At best, the examiner is using these two references, as well as the others, as mere parts bins, selecting from each only so much as the examiner needs in fabricating rejections without regard to the remainder.

Three different appeals have clearly proven over and over again the examiner's penchant for hindsight fabrication without regard to evidence and without regard to legal motivation.

The more strenuously the examiner argues against patentability, the less credible that mere examiner argument becomes; especially evidenced by the many errors in recharacterizing the rejections in the enumerated paragraphs of the several office actions.

CLAIM 6

6. A method of using the swatter 10 of claim 5 comprising:

stretching said lash 34 by pulling said distal end 18b thereof generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;

latching said lash distal end 18b to said latch 20;

gripping said handgrip 14 to aim said rod distal end 12b at said insect; and

pulling said trigger 24 to release said latch 20 to spontaneously contract said lash 34 for swatting said insect.

The examiner has yet again overlooked this claim in the para. 2 rejection copied from the previous office action.

Perhaps the examiner is merely arguing "intended use" for this claim 6 as found in the page 7 remarks,

But claim 6 is expressly a method claim, and the sine qua non of a method claim is indeed its actual or intended use or function.

In claim 6, the lash 34 is pulled from its fixed-at-one-end and loose-at-the-other-end condition to its stretched

condition and latched.

In White, the 3-bands are shown only stretched and attached, but in the loose condition thereof they would clearly not be attached to the toy gun, and could be stretched in at least three different permutations.

However, Section 103 requires evidence and legal motivation conspicuously lacking in the examiner's mere listing of claim 6 in the rejection.

And, claim 6 requires aiming at an insect, not extant in White or Watkins, and pulling the trigger to cause the attached lash 34 to whip towards the insect.

In White, the 3-bands would instead be hurled away, and do not a whip effect.

The examiner has listed claim "7" at the top of page 3, but claim 7 has been canceled; yet again, more evidence of the rote rejection.

CLAIM 21

21. An insect swatter comprising:

an elongate rod 12 having a proximal end 12a, and an opposite distal end 12b for being aimed at an insect and including a keyhole slot 30;

a gun handgrip 14 fixedly joined to said rod proximal end 12a;

a latch 20 pivotally joined to said handgrip 14 adjacent to said rod proximal end 12a;

means 24, 20b for selectively releasing said latch 20 and including a trigger 24 operatively joined to said latch 20 for releasing said latch 20 upon pulling said trigger 24;

an elastic lash 34 including first and second annular rubber bands 36, 38 knotted together at an intertwined knot 40 therebetween;

said first band 36 having a proximal end 18a forming a lash first loop 36 disposed through said keyhole slot 30 for fixedly retaining said lash 34 to said rod distal end 12b;

said second band 38 having an opposite distal end 18b forming a lash second loop 38 positionable around said latch 20 for being releasably retained thereby; and

said lash 34 is sized for being elastically

stretched from said keyhole slot 30 to said latch 20 so that release of said second loop 38 from said latch 20 spontaneously contracts said lash 34 for swatting said second loop 38 against said insect.

This claim 21 is a new claim recently added, but not addressed by the examiner in the final rejection except for the mere listing thereof in para. 2 (and para. 3).

In claim 21, the keyhole slot 30 is recited through which the second band/loop 38 is affixed to the rod distal end 12b.

The lash 34 is shorter than the rod 12 and is sized to be elastically stretched from the slot 34 to the latch 20 for spontaneous contraction to swat the insect in whip fashion.

At the bottom of page 2, the examiner admits that White does not show the keyhole slot, but combines Watkins for its slot 34.

The examiner then merely argues that it would have been obvious "to provide White with a keyhole slot as shown by Watkins since merely one mechanically equivalent fastening means is being exchanged for another and the function is the same."

Remarkable, quite remarkable is this brazen conjecture by the examiner without regard to evidence, and even without regard to the very conjecture being proffered.

This brazen conjecture is more evidence that the examiner will argue anything to reject the claims, without regard to evidence and even without regard to logic.

Abuse of examination practice, this brazen conjecture is; and no patent application would ever be allowed by this examiner using such unwarranted "rationale," be it "imaginative" or not.

"Mechanically equivalent fastening means" the examiner opines.

Let's conduct that "exchange" proffered by the examiner.

Remove the sight 4 from White.

Next, introduce the slot 34 in the barrel where that sight 4 was.

And, next insert the end of the 3-bands into that slot 34.

What have we?

We now have a toy gun rifle with the 3-bands firmly attached to the end slot 34; and let's fire that toy gun.

What happens?

Of course, the 3-bands would be released from the extension 10 at their left end, but, just as well, the right end of the bands would remain attached to the barrel due to the slot 34 exchanged therewith by the present examiner.

If this is not the quintessential example of "inoperable for its intended use," then nothing is.

But, this examiner affords no weight to "intended use" either in Appellant's claims, and even now, in the examiner's proffered combination of White and Watkins.

No, the examiner must reject all the claims, and any reason will do.

In the Gordon case cited above, the examiner applied a reference upsidedown to reject the claims.

However, upsidedown rendered the proposed modification inoperable, and that the Federal Circuit found was evidence of teaching away.

Here, the present examiner requires modification of White to attach the 3-bands to the added slot. Why, because Appellant's specification and claims so teach. And, the examiner must make this combination if he hopes to reject the claims.

But, the examiner's proposed modification clearly renders inoperative the White toy gun for its primary objective "to discharge an elastic band," at col. 1, ll. 1-3; and "catapulted through the air," at col. 1, ll. 17 & 18; and "the bands will be projected by reason of their own

resilience to a considerable distance," col. 3 (page 2), ll. 1-4.

Clearly, the examiner's own, distorted contentions are evidence in and of themselves of the blind rush to apply hindsight, not based on evidence in the references (McLaughlin), but expressly based on Appellant's own claims, one-by-one-by-one.

CLAIM 8

8. A method of using the swatter 10 of claim 21 comprising:

pulling said lash second loop 38 to stretch said lash 34 generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;

latching said lash second loop 38 around said latch 20;

gripping said handgrip 14 to aim said rod distal end 12b at said insect; and

pulling said trigger 24 to release said latch 20 to spontaneously contract said lash 34 for swatting said insect.

For method claim 8, the examiner simply contends at page 3 that "the combination of White as modified by Watkins performs the method as recited." This, the examiner baldly opines without evidentiary or legal support.

At page 7, the examiner compounds the errors of rejection by merely arguing that although White does not teach use for swatting insects, it is nevertheless so capable; and that intended use is "not material to article claims."

Further compounding these errors, the examiner attempts to switch the burden of proof to the Appellant, and baldly states that "applicant has submitted no evidence that White would not function to swat insects."

Claim 8 is a method claim, not an "article" claim, and is well entitled to due weight for the express elements

recited therein, for which the examiner has offered no evidence himself.

Intended or not to swat insects is irrelevant to the Section 103 rejection of method claim 8 since the examiner, not this Appellant, has the burden to show how White would have been modified, why that modification would have been made, and the legal motivation therefor.

Assuming arguendo that White could or would have been used to catapult the 3-bands toward an insect, the examiner has failed to show that the toy gun in White would accomplish that objective in the manner recited in claim 8.

Clearly, White teaches hurling the 3-bands completely away from the barrel 1.

Claim 8 requires using the lash as a whip, which whip remains attached at one end to the rod, with the tip end of the lash being used to strike the insect.

Could not the differences be any greater?

Apparently not to this examiner who would have one skilled in the art reconstruct the toy gun in White in fundamental and wholesale change from its intended design.

But, that original design has no significance to the examiner under his own standard of patentability, which clearly does not conform with the MPEP and the case law presented therein, or to the basic standards presented by the Federal Circuit.

The examiner has attempted to exert his standard of (non)patentability thrice now before three Boards of Appeal in the history of this invention, and thrice now the Boards have reversed the examiner, and his "rather imaginative rationales." When will this abuse of examination stop?

Will the present Board find some reason, any reason, to sustain any one or more of the myriad rejections being proffered by the examiner to save face for the PT0?

We now even have the imprimatur of the group Director who authorized re-opening of prosecution.

If the examiner is yet again reversed, for the fourth time, what statement will that make in the PTO?

This Appellant is now fearful, fearful, of the PTO bureaucracy which permits this abuse of examination to continue.

The last Board was overly polite in reversing the examiner for his "rather imaginative rationale," but prosecution before the PTO is an enormously strenuous and expensive and esoteric practice containing trap after trap for every applicant, and "rather imaginative rationale" should never be condoned or permitted.

Examiner error is typically addressed by allowing an applicant, not the examiner or the PTO, to invest more time and effort and expense to correct that error; and yet, any Appellant error often results in harsh PTO action, and further expenditure of time, effort, and expense by Appellant, not the PTO.

Three favorable appeals this Appellant has already had, with the enormous expenditure of time and effort and expense.

Reopen prosecution this examiner and his Director do following the favorable appeal decision, and without regard to Rule 104.

Now, this fourth appeal. Will it be successful or not?
And, will further appeal be necessary?

CLAIM 10

10. A swatter 10 according to claim 21 wherein:

said latch 20 is pivotable between a cocked position wherein said latch 20 extends generally perpendicularly to said rod 12 for retaining said lash second loop 38 thereon, and a fired position wherein said latch 20 is inclined forwardly toward said rod distal end 12b for allowing said lash second loop 38 to slip off said latch 20 for spontaneously contracting said lash 34; and

said trigger 24 is operatively joined to said latch 20 for releasing said latch 20 to pivot from said cocked position thereof to said fired position thereof

upon pulling said trigger 24.

The examiner has failed to address this claim in para. 2.

Claim 10 is a combination claim, and the pivoting latch 20 and releasing trigger 24 combine with the affixed lash 34 to whip the lash when used.

However, the examiner fails to afford any weight to intended use, notwithstanding the substantial structural differences in this claim over White and Watkins.

As indicated above, the 3-bands in White must be catapulted away, and the extension 10 therefore has different effect.

When Appellant's lash 34 is affixed at its proximal end in the keyhole slot 30, its liberation is prevented; and then, the spontaneous contraction due to the triggered latch provides effective aiming and striking capability of the whipped lash, when used.

When not in use, the lash 34 remains fixed only at the keyhole slot 30 and is loose, as recited in claim 10 by dependence from claim 21, in a configuration neither possible nor suggested by White and Watkins, and the examiner has not shown otherwise.

CLAIM 11

11. A swatter 10 according to claim 10 wherein said latch 20 includes a thumbgrip 28 extending generally perpendicularly therefrom for manually returning said latch 20 to said cocked position thereof.

At page 3, the examiner simply identifies the hammer 9 of White, without more, and without any analysis whatsoever.

This is clear evidence by the examiner of evaluating naked elements out of context.

Claim 11 is a combination claim and it is entitled to

the full and complete analysis under Section 103, just like any other claim, be it independent or dependent.

The examiner appears to suggest that any hammer for a trigger would have been obvious per se.

But, this is not the standard under Section 103.

The hammer 9 in White does not extend generally perpendicularly from the extension 10, and cooperates therewith differently than in Appellant's claim 11.

The hammer 9 in White cooperates also with the 3-bands and the spring-supported sight 4 in catapulting away the 3-bands, notwithstanding the examiner's attempt to merely substitute the slot 34 from Watkins for that sight 4.

Why have a spring 5 cooperating with the sight 4, if the slot 30 from Watkins could be merely substituted?

To be certain, as simple as the toy guns in White and Watkins appear to be, they are indeed not, from a mechanical standpoint.

And, Appellant's insect swatter is further mechanically different than both White and Watkins.

Without the proper orientation of the thumbgrip and latch, the lash recited in claim 11 might not be discharged at all, or might hang-up during firing, or might not be properly re-cocked.

A thumbgrip, per se, may itself be old, but the thumbgrip recited in claim 11 operates in combination in a manner clearly overlooked by the examiner in the rush to reject the claims.

CLAIM 12

12. A swatter 10 according to claim 11 further comprising:

a spring 26 joined between said trigger 24 and said handgrip 14;

said trigger 24 being pivotable between a cocked position holding said latch 20 in said cocked position thereof, and a fired position releasing said latch 20

for pivoting said latch 20 to said fired position thereof; and

 said spring 26 being positioned for providing a returning force on said trigger 24 to return said trigger 24 to said cocked position thereof upon release of said trigger 24.

For claim 12, the examiner identifies springs 15,16, yet again out of context from the combination recited in claim 12, and against the teachings of Watkins being combined with White.

Claim 12 recites a combination in which the trigger spring 26 is positioned to return the trigger to the cocked position upon release of the trigger.

In White, the spring 15 cannot provide this capability because the spring 16 causes the lever 7 to rotate clockwise when the trigger 13 is pulled, and the extension 14 is then trapped against the lever 7 preventing its return to any cocked position.

White at col. 2, ll. 5+, then expressly states that the hammer 9 must be manually pressed rearwardly to return the trigger 13 to its former position.

Accordingly, mere release of the trigger 13 itself cannot return the trigger 13 to its cocked position, and the examiner has therefore failed to substantiate the rejection of claim 12; and has failed to address these remarks previously presented.

MPEP 706.07(f) requires the examiner to answer all material traversed, yet the examiner has continually failed to do so; instead repeating previous rejections from the last office action (even in error), and then using the page 7 "Response to Arguments" section in broad sweep without regard to the specific traverse presented claim-by-claim by Appellant.

Claim 12 recites a specially configured spring, but a spring-is-a-spring to this examiner, and must be per se obvious; which clearly is not the case under the Section 103

standard.

CLAIM 13

13. A method of using the swatter 10 of claim 12 comprising:
cocking said thumbgrip to position said latch 20 into said cocked position thereof;
stretching said lash 34 by pulling said lash second loop 38 generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;
latching said lash second loop 38 around said latch 20;
gripping said handgrip 14 to aim said rod distal end 12b at said insect; and
pulling said trigger 24 to release said latch 20 to said fired position thereof to spontaneously contract said lash 34 for swatting said insect.

Yet again, the examiner simply opines at page 3 that "the combination of White in view of Watkins performs the recited method," when clearly that is not the case, and the examiner has abdicated his responsibility under Section 103 to evaluate claim 13 in the whole.

As indicated above, the triggering mechanism of White cannot function in the manner recited in claim 13.

The 3-bands in White are already shown on the toy gun, and it is merely speculation how they were mounted thereon when there are at least three permutations of mounting either left end first, or right end first, or both left and right ends simultaneously.

And, the examiner has failed to show any legal motivation to substitute the slot 30 of Watkins for the sight 4 of White, which if so done would clearly render inoperative the toy gun of White for its intended purpose.

In claim 13, the trigger is pulled to spontaneously contract the lash in a method having no counterpart in White and Watkins in which the 3-bands would be catapulted away from the barrel 1, and would not a whip effect.

CLAIM 14

14. A swatter 10 according to claim 10 wherein:
said lash 34 has an unstretched length;
said rod 12 and latch 20 have a collective cocked length measured between said keyhole slot 30 and said latch 20 in said cocked position thereof; and
said cocked length is selected for stretching said lash 34 to about its maximum stretchable length without breaking thereof.

Claim 14 has yet again been overlooked by the examiner in para. 2, and therefore no basis has been provided to reject this claim for any reason.

Claim 14 recites corresponding lengths of the lash and rod for stretching the lash to its maximum length without breaking.

No such teaching is found in White and Watkins, and the examiner cannot rely on mere speculation to support this rejection.

Indeed, the 3-bands 19 illustrated in figures 1 & 2 of White appear quite fat, the connections 19 appear quite fat, and the thickness of those bands appears quite uniform, which all suggest that the 3-bands are hardly stretched at all, let alone stretched to their maximum length without breaking.

The examiner can readily test this interpretation by connecting together 3-bands in the manner of White and stretching those bands around the ends of two pencils separated apart.

This test will clearly show that each of the bands will decrease significantly in thickness and become distorted in a manner not evident in White.

Paras. 47-49 explain the significant advantages in this species including the increased striking range having no bearing in White in which the 3-bands are simply hurled away without any whipping action being relevant.

CLAIMS 15 & 16

Para. 2 of the office does not list claims 15 and 16 under the Section 103 rejection over White and Watkins.

However, at page 3 of the office action claims 15 and 16 are addressed, but why?

The reason is that the examiner has merely copied, verbatim, without thought, the previous rejections of claims "7-16" from para. 5 of the previous office action over White and Robinson.

What then is the examiner's intended status of claims 15 and 16, and how should the Board evaluate them?

Are they being rejected or not?

As for claim 15, the examiner admits at page 3 the failure of White to disclose the three-times cocked length, but the examiner merely concludes obviousness for "maximum stretchable length."

Examiner conclusion is neither evidence nor legal motivation, and is without merit.

And, the examiner's conclusion is illogical. Claim 15 does not recite "maximum stretchable length," which is clearly not disclosed or suggested in White, which instead plainly illustrates rather fat, lightly stretched (perhaps), 3-bands.

The attached lash recited in claim 15 is an operative element of the insect swatter apparatus or machine; whereas the loose 3-bands in White are merely the work product or ammunition.

The three-times cocked length has particular advantage in the whip configuration as disclosed in paras. 48 & 49 of the specification, which the examiner has clearly overlooked in the whole analysis.

Claim 15 also recites the striking range of the whip being twice the unstretched length, having no counterpart in

White because the 3-bands are shot away, and do not act like a whip.

Claim 16 recites the equal lengths of the two bands with the midway knot for the special benefits presented at paras. 56 et seq.

At page 3, the examiner merely opines that "White contemplates" these features, when no such teaching is found therein.

To the contrary, the figures show 3-bands of different lengths, and two knots not being midway.

White expressly teaches using old inner tubes for the bands, in one, two, or three bands.

And, how would those old tubes be used? The examiner suggests in the whole, but it is unlikely such tiny size tubes would have been found either in 1930, or today.

It is speculated that the old tubes would have been cut to size, and it would have been impossible to cut two or more tube bands to identical size.

And, most importantly, there is nothing in White, or Watkins, to teach or suggest, any special form of the 3-bands, other than as mere ammunition to be shot away.

CLAIM 17

17. An insect swatter 10 comprising:
 an elongate rod 12 having a slot 30 at a distal end 12b thereof;
 an elastic lash 34 configured in a figure eight with first and second knot-less loops 36,38 at opposite ends, and joined together at a knot 40 therebetween;
 and
 said lash first loop 36 is fixedly retained in said slot 30 to prevent disconnection therefrom when said lash 34 is whipped along said rod 12.

Independent claim 17 has also been overlooked by the examiner in the mere grouping together of claims and arguments without the requisite analysis under Section 103

for each and every claim.

Independent claim 17 is unlike independent claims 1 and 21, and is differently distinguishable over the applied references.

In this claim, the lash 34 is in figure-eight form, with the first loop fixedly retained in the rod slot 30 to prevent disconnection therefrom.

No such configuration is disclosed or suggested by White and Watkins, and the examiner has not shown otherwise.

In White, the 3-bands are not connected in any manner to the toy gun when not in its "intended use." The 3-bands are merely the work product or ammunition, and do not form any part of the toy gun itself.

Only, when the toy gun in White is used as "intended" are the 3-bands then temporarily seated on the extension 10 and sight 4, and both those seats are not fixed in any manner to prevent disconnection therefrom when the 3-bands are fired.

The examiner's rejection of this claim is conspicuous for the lack of any mention thereof or evidentiary support.

At page 7, the examiner generalizes that certain recitations are mere "intended use," but does not identify any claim or any claim feature, leaving to speculation any basis to reject any claim.

The examiner even opines that the method claims are not entitled to any weight because of the "intended use" thereof; which is indicative of further error.

The examiner must intentionally disregard the fundamental configurations of the toy guns in White and Watkins, and disregard their "intended use," and then disregard the express combinations recited in Appellant's claims in order to fabricate the rejections.

It appears that the examiner evaluates the claims not in the whole, but for the plain, naked elements thereof; finding naked elements in any reference he can find (the file

history amply shows this penchant); then disregards the combination, function, use, and purpose of the claims to reject all claims without regard to any objective standard under Section 103.

MPEP 2141.02 cites case law, including *In re Antonie* for example, for the "As a Whole" inquiry which the examiner must perform:

In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification ... Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention as a *whole*, and not some part of it, which must be obvious under 35 U.S.C. 103.

The examiner fails in evaluating Appellant's claims in the whole, firstly by intentionally disregarding features literally recited in the claim under the guise of mere "intended use," and then disregarding the cooperation and function and purpose of the recited claims.

It is remarkable that the examiner has withdrawn the Section 102 rejection over White, but at the same time has merely repeated verbatim that rejection under the Section 103 rejection, and addressing the admitted shortcomings from Watkins, without regard to the fundamentally different configurations of the toy guns in these two references, and the apparent impossibility of combination thereof.

"Rather imaginative rationale" continues unabated from this well experienced examiner, who has and continues to merely argue that no claim is patentable because, because, well just because White and Watkins could somehow be combined in a manner somewhat similar to Appellant's various claims.

That combination by the examiner clearly does not meet the requisite test.

Recall In re Gordon, cited above: "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

The examiner's rejections are clearly based on this impermissible standard that White "could be so modified" by substituting the slot from Watkins for the spring-mounted sight 4, because they are nothing more than "mechanically equivalent," so the examiner merely argues,

"Mechanically equivalent" based on what evidence, or what authority?

As clearly indicated above, attaching the 3-bands in White in a slot at the end of the barrel 1 would clearly destroy the intended purpose of the toy gun, a plain fact which the examiner must, must overlook in fabricating the rejection.

This error, among others, is particularly egregious because the examiner has now had 12-years in examining this application and its parent, and the examiner is well experienced before the PTO, and we have now had multiple appeals, all reversals by three Boards now.

One would think that the examiner would expend extra caution in evaluating the claims and conducting the search and studying the requisite provisions of the MPEP, including the various legal motivation provisions of ch. 2100, before putting to print his bases for rejection.

But, no, this has not been done since the examiner has clearly used the expedient of copying verbatim arguments from previous office action(s), failing to address the specific traverse by Appellant in past amendments, and even making blatant errors in presenting the rejections as explained above.

This abuse of examination is transparent, and poisons each and every rejection.

But, of course, the Board must evaluate de novo the

various rejections, and the Board will attempt to give the examiner the benefit of doubt, and somehow find logic in the spurious arguments of the examiner, even where no logic can be found.

The examiner's comments are numerous, and the Appellant is duty bound by the Rules to address each and every one of those comments and point out the errors thereof. However, the errors are too numerous, and scattered between the copied rejections, and the response-to-argument section, rendering further difficult the rebuttal thereof.

CLAIM 18

18. A swatter according to claim 17 further comprising:

a handgrip 14 fixedly joined to a proximal end 12a of said rod 12 opposite from said distal end 12b thereof;

a latch 20 pivotally joined to said handgrip 14 adjacent to said rod proximal end 12a for releasably latching said lash second loop 38; and

a trigger 24 operatively joined to said latch 20 for releasing said latch 20 upon pulling said trigger 24.

Claim 18 is another combination claim in which the handgrip 14, latch 20, and trigger 24 cooperate with the attached lash 34 to form a whip.

There is no such counterpart in White in which the toy gun is differently configured to shoot the 3-bands away, with no type of whip even contemplated.

At page 4, the examiner first argues that the "rubber bands [of White] can be thought of as being fixed on the gun."

But, claim 18 recites not a "fixed" attachment for the lash second loop, but a "releasable" latch which cooperates with the lash first loop fixedly retained in the end slot having no counterpart in White.

CLAIM 19

19. A swatter according to claim 18 wherein said lash 34 includes a pair of annular rubber bands 36,38 joined together in series at said knot 40, and having a collective spring rate equal to one-half the spring rate of either band.

Claim 19 was amended, but the examiner has merely copied at page 4 his previous comments regarding the pre-amended claim 19, and has therefore failed to present any basis to reject this claim.

Claim 19 recites a pair of bands 36,38 in series, with a collective spring rate equal to one-half the spring rate of either band; yet again for the benefits expressly stated in the specification, see paras. 62 et seq.

Of course, the examiner merely argues that the multiple bands of White would "inherently" have the reciprocal spring rate, but this, the examiner opines without due regard to White, and its express teachings, and its lack of teachings.

The 3-bands in White are mere ammunition, and White fails to teach any criticality or advantages of different forms thereof, since those bands are intended only to be shot away.

The 3-bands in White are clearly shown as having different lengths.

The 3-bands in White are taught to be made from old tire tubes, and as such they would "inherently" be differently sized, since fabricating them identically from old tubes would be impossible per se.

Accordingly, it would be impossible to have even 2-bands in White have a collective spring rate equal to one-half either band, because no two bands in White could possibly be identical.

Claim 19 is a particular species claim having

particular benefit in the recited whip configuration, but, alas, even such a picture-claim species, without even any hint from White and Watkins is found not allowable by the examiner.

Why?

Because the examiner continues his prejudgment of this application, and will not allow even one claim, not even a picture claim.

The examiner continues to poison all the rejections by using his considered experience before the PTO to fabricate rejection after rejection, without regard to the legal requirements.

The learned examiner's failure to fabricate even cogent rejections is evidence in and of itself of the nonobviousness of all the claims, because the examiner is in a special position before the PTO of having Appellant's written description and claims as a guide, a particular advantage which one skilled in the art would not have.

Imagine one skilled in the art presented with White and Watkins, and without anything else.

What would that skilled person do with those two different references?

Would he combine them, and how, and why?

That is the test under Section 103.

The skilled person needs a reason, legal motivation, to combine references; and that typically entails problem solving.

What problems are presented in White and Watkins which need solving?

What problems has the present Appellant presented in the specification?

And, confronted with those problems, would or could one skilled in the art modify and combine White and Watkins?

Clearly not, because White and Watkins teach different toy guns which operate differently, and both are specifically

configured for shooting away projectiles.

Appellant's claims recite various forms of whips.

What is a whip?

The lash is expressly attached at one end only to the support rod; and the lash is configured to function as a whip by being stretched to temporarily latch its distal end.

When the lash is fired, the proximal end remains attached to the rod, and the distal end whips outwardly and stretches forwardly to strike an insect in the fashion of a whip, which then releases the kinetic energy at the small contact point concentrating that energy on the insect.

The present Appellant has already been awarded U.S. Patent 6,851,218, over the strenuous rejections of the same examiner; and now, the present application discloses, and claims, particular improvements thereof having no teaching or suggestion in any of the references being applied by the examiner.

Even claim 19, with its species is unpatentable according to the present examiner. What then would be patentable to this examiner?

This examiner has created too high of a standard, a personal standard, not founded in reality under Section 103, or under the various MPEP provisions, including ch. 2100 in particular.

To be certain, this examiner knows well how to fabricate rejections, ad infinitum, for that is his training.

But, this examiner continues to abuse his discretion, and continues to fabricate "rather imaginative rationales" without regard even to the BPAI, who recently reversed his previous final rejections in this application, now re-opened for prosecution yet again.

Will this reopening of prosecution ever end?

CLAIM 20

20. A swatter according to claim 18 wherein said pair of rubber bands 36,38 are identical in size, cross section, and material composition, and have equal lengths to position said knot 40 midway between said first and second loops 36,38.

At page 4, the examiner opines that "the rubber bands of White appear to be identical in size, etc ..."

"Appear?"

The examiner has the burden of proof under Section 103, and has clearly failed to present even a prima facie showing.

The 3-bands in White are made from old tire tubes.

The 3-bands in White are mere ammunition and have no disclosed cooperation with the toy gun, other than for being shot away.

White fails to disclose any critical or new features for the bands themselves since they are mere work product, and not part of the gun apparatus.

Where then in White is any teaching that those bands "appear" to be identical?

Clearly there is none.

And, to the contrary, the figures clearly show different length bands, and White expressly teaches making those bands from old tire tubes which, of course, would result in different size bands, since it would be impossible to hand make identical bands.

At page 8, the examiner attempts to use the "not to scale" contention in support of the "appearance" of the bands in White.

The examiner is reminded that Section 103 is not based on "appearance" but on evidence and teachings for those skilled in the art.

Speculation is not permitted under Section 103, and the examiner's mere contention is nothing more than unwarranted speculation.

"Could be considered in 1930 to be identical ..." is a

bald fabrication by the examiner, and not supported by evidence, or even plain logic.

The examiner, himself, could easily test his theory by taking even a "modern" tire tube and making two or three bands therefrom in the fashion illustrated in White.

To be certain, it would be impossible for the examiner to fabricate identical bands.

No, the bands in the 1930's White patent cannot be "considered" to be identical, and the examiner has not shown otherwise.

To the contrary, the examiner's bald contention merely adds to the errors of rejections, and poisons any objectivity in the various rejections.

Even evaluating the examiner's bases for rejection in favorable light will clearly show that they are unsubstantiated, incomplete, and replete with error, affording little, if any weight, to the various claims.

CLAIM 22

22. A swatter according to claim 3 wherein said rod 12 and latch 20 have a collective length L2 from the juncture of said lash proximal end 18a and said rod distal end 12b which is at least three times the unstretched length L1 of said lash 34.

Independent claim 21 has been addressed above.

Claims 21-23 were added in the last amendment, and the examiner has merely added those claims to his list of rejections, but has failed to address them in any fashion under Section 103.

The examiner has simply copied, errors included, his previous comments, stopping at claim 20 on page 4, without any continuation for claims 21-23.

Claim 22 recites the at least three times stretching capability of the two-band species of the lash 34 for the

considerable benefits presented in the specification, and addressed above.

At page 3 in reference to claim 15, the examiner merely opines that the bands in White could be stretched to maximum length, but that is not what is recited in claim 22.

The 3-bands in White are formed from old tire tubes.

How would it even be possible that even by chance they could meet the special limitation of claim 22?

It is not possible.

The two-bands in series recited in claim 22 require special configuration conforming to the recited rod for effecting the recited three-times stretching for the intended striking range, quite relevant to the whip, but quite irrelevant to the projectile-shooting toy gun of White.

CLAIM 23

23. A swatter according to claim 5 wherein said handgrip 14 includes a latch stop 22c adjacent to said latch 20 for limiting rotation thereof when said stretched lash 34 pulls said latch 20 into spontaneous abutment with said stop 22c as said lash distal end 18b is released from said latch 20 to spontaneously contract said stretched lash 34.

Claim 23 was added to replace method claim 4 and depends from claim 5.

In this species, the latch stop 22c from paras. 35 & 39 is introduced adjacent to the latch 20, and under spontaneous contraction of the duplex lash, the latch spontaneously abuts the stop and adds forward inertia in maintaining the line-of-sight aiming at the intended insect. In other words, the insect swatter goes "BANG" and the swatting results are improved.

Such "bang" is a mechanical effect occurring simultaneously with the release of the lash and improves swatting performance, not found in the simple hand release of

the lash without the recited firing mechanism.

The specification explains in detail the special configuration of the insect swatter and its constituent parts in substantially improved performance, for which the examiner has afforded no weight, perhaps as mere "intended use," but the "whole" analysis dictates otherwise.

Claim 23 does not recite a latch stop in a vacuum.

At page 4, the examiner simply opines that "White shows a latch stop 14 ...," but that contention is taken out of context in White, and disregards the whole of claim 23.

Claim 23 depends from claims 5, 3, and 1.

The examiner has already used the extension 10 in White for the recited latch.

The examiner has also already used the trigger 13 in White.

Claim 23 introduces yet another element, the latch stop 22c adjacent to the latch; and the examiner has overlooked the recited cooperation.

The stop 22c, shown in figure 3, limits rotation of the latch 20 when the lash is fired, and then the latch is pulled by the fired lash into spontaneous abutment (Bang) with the stop.

The examiner simply contends at page 4, that the "latch stop 14 [in White] ... prevents the latch 10 from moving until the trigger 13 is pulled," but this is irrelevant to claim 23.

The extension 14 in White is part of the trigger 13, and moves only when the trigger is pulled. It then releases the extension 10 to release the 3-bands.

Claim 23 could not be any more different than White, and the extension 14 in White clearly does not have any effect to stop the extension 10 when, instead, it is released by the trigger extension 14.

Why then has the examiner chosen to overlook even the species of added claim 23?

Not one claim has, or will, the examiner allow.

Why must this application be (re)examined de novo by the Board of Appeals, who are quite busy, with a typical 3-year backlog?

Can, and will, the Board put an end to the "rather imaginative rationale," if "rationale" in fact it is, of this examiner?

Does the group Director have any control over his examiners to reign in "rather imaginative rationale?"

In this case, the Director has expressly approved the re-opening of prosecution, and these meritless rejections.

The above traverse is merely representative of the many errors in rejection proffered by the examiner; and there are others.

Fundamental to all rejections, is the examiner's attempt to blindly modify the toy gun of White, and clearly render it inoperable for its intended purpose. And, without a doubt, that modification is clear error, not based on any objective teachings of the art, and entirely based on Appellant's claims themselves.

Yet, that rejection is not enough; so the examiner is also rejecting the claims over the reverse combination of Watkins and White, later addressed hereinbelow.

To be certain, the examiner is skilled at fabricating rejections, so skilled in fact, that the examiner now dispenses with evidence and the law, and simply fashions rejection-after-rejection using the naked elements of the various claims without any regard to context, without any regard to cooperation and function (mere "intended use"), and clearly without regard to the requisite "whole" analysis mandated by case law under Section 103.

These many errors by the examiner should now be well apparent, and wholly undermine the rejections of record.

Accordingly, reversal of the rejection of claims 1, 3, 5, 6, 8, 10-14, and 17-23 under Section 103(a) over White and

Watkins is warranted and is requested.

Ground 2

Ground (2) - whether claim 9 is unpatentable under 35 USC 103(a) over U.S. Patent 1,779,507-White, U.S. Patent 2,642,057-Watkins, and U.S. Patent 102,594-Robinson.

Appellant traverses this rejection, and requests reversal thereof.

CLAIM 9

9. A swatter 10 according to claim 21 wherein:
said latch 20 extends upwardly from said handgrip 14;
said keyhole slot 30 is open downwardly in a direction opposite to said upward extension of said latch 20 and loosely joins said lash 34 to said rod 12; and
said lash 34 is inclined upwardly substantially straight from said keyhole slot 30 to said latch 20 when latched thereto, and said knot 40 is positioned atop said rod 12.

Firstly, claim 9 depends from claim 21, not claim 1 as introduced by the examiner in para. 5.

Secondly, like White and Watkins, Robinson is nonanalogous art since its field of endeavor is yet again toy guns and not insect swatters; and it is not relevant to Appellant's expressly stated problems described in the specification and summarized above.

At page 8 of the office action, the examiner merely states, without evidentiary basis, that White and Watkins are "reasonably pertinent to the particular problem with which applicant was concerned," an error traversed above; but the examiner has conspicuously omitted Robinson in that contention.

Both White and Watkins disclose toy guns, and the

problems presented therein are quite irrelevant to any of the many problems expressly listed in the specification by the Appellant.

The examiner has simply failed to identify any problem in White and Watkins, because there are none relevant to Appellant's problems.

The same is true of Robinson.

Robinson discloses another toy gun specifically configured for shooting the missile ball D. Any problems presented therein are clearly not relevant to Appellant's insect swatter whip, and the examiner has conspicuously failed to identify any.

It is quite conspicuous that the examiner continues to apply nonanalogous toy guns, and has continually failed to uncover and list of record any relevant insect swatter reference, of which, one can only guess, there would be many.

Rule 104 mandates thorough searching.

Why then has the examiner not listed any references specific to insect swatters? Perhaps, because such references would be evidence to teach away from Appellant's novel swatter?

And, every one of the three references White, Watkins, and Robinson also teaches away from Appellant's recited whip insect swatter because all three references expressly teach different guns for shooting projectiles; and none of which has any teaching for whipping performance, function, purpose, or "intended use."

Notwithstanding the examiner's contention in para. 5, the elastic cord-C of Robinson cannot be the equivalent of any rubber band relevant to Appellant's claims or White or Watkins since claim 9 recites a lash formed by a pair of bands 36,38; White teaches three bands; Watkins teaches a single band; and Robinson discloses a single cord tied together at d.

The examiner contends that Robinson "shows a keyhole

slot..." yet no such element is found in Robinson. Robinson clearly states and clearly illustrates that the cord-C is retained at its left end around the "knob a."

That knob-a extends downwardly from the barrel-B, and has an enlarged head.

Where is any slot disclosed or shown in Robinson?

Where is any keyhole configuration disclosed or shown in Robinson?

At page 9, the examiner presents anew that the two projections in Robinson "forms a slot which a key could be inserted into."

A remarkable interpretation of Robinson without regard to plain English.

It is well known that an examiner can take liberty in broadly construing claim elements during examination, but with what, if any limit?

The examiner has failed to show that the common dictionary definition of keyhole supports his remarkable interpretation of Robinson.

The examiner has already applied Watkins for the "keyhole slot 34," but that slot has no similarity with the two projections of Robinson.

And, more importantly, Appellant's specification defines the keyhole slot 30 in specific form, clearly overlooked by the examiner.

With this unwarranted interpretation of Robinson, the examiner merely concludes that it would have been obvious to "provide the swatter of White as modified by Watkins with a downwardly extending keyhole slot as shown by Robinson since merely one mechanically equivalent key hole slot is being substituted for another and the function is the same."

Yet again, the examiner's contention is blatantly erroneous, and fails to afford any weight to the three references or claim 9, and is unsupported by any provision of the MPEP or case law.

Firstly, the sight 4 in White extends upwardly and is spring loaded. The knob-a in Robinson extends downwardly and is fixed.

The 3-bands are releasably retained on the sight 4; yet the cord-C appears fixedly attached to the knob-a.

The sight 4 permits the 3-bands to be liberated; and the knob-a does not appear to permit liberation of the cord-C, but allows that cord-C to liberate the ball-D.

And, the ball configuration of Robinson expressly introduces a break in linearity of the cord, which therefore cannot be straight as recited in claim 9.

These are fundamental features of the references White, Watkins, and Robinson; and are quite inapposite from each other and from Appellant's claims.

Where then is the examiner's evidentiary support that the slots are equivalent or serve the same function, when this is clearly not the case, nor supported by any evidence in the references?

As for the examiner's contention of obviousness, that is a mere conclusion, and is not the legal motivation required by the MPEP. And, to the contrary the references teach away from each other since the toy in White is configured to hurl the 3-bands, and the toy in Watkins is configured to shoot peas, and the toy in Robinson is configured to shoot the ball D while retaining the cord-C; and the structures and functions are correspondingly different, not the "same" as the examiner baldly contends.

In claim 9, the keyhole slot 30 is open downwardly for the benefits stated in the specification.

If the downward knob-a of Robinson were used in White to attach the right end of the 3-bands under the barrel 1, that toy gun would clearly be rendered inoperable for its intended purpose; which, yet again, is evidence of nonobviousness.

The examiner continually attempts to use naked elements

from diverse references in classic hindsight reconstruction without regard to context or whole.

At page 8, the examiner rotely lists McLaughlin for hindsight reasoning based on "only knowledge which was within the level of ordinary skill," but, the examiner's many mere contentions are clear evidence of no evidentiary support therefor.

"Only knowledge within the level of ordinary skill?"

How does that "knowledge" permit the examiner to reconstruct White to eliminate the aft sight 4, and substitute the slot-mounting feature from Watkins, and thereby intentionally disable the toy gun for its express purpose of shooting away the 3-bands?

It is clear that the examiner does not afford any weight to "intended use," either in Appellant's claims, or in the very references being applied.

How then could any patent application issue into a patent under this examiner "rationale?"

To this examiner, it is quite permissible to destroy the fundamental "intended use" of the toy gun in White for shooting the 3-bands, and attach the 3-bands at the sight 4, because the examiner needs this reconstruction to reject Appellant's claims.

But examiner need is not the same as permitted modification based on legal motivation without destroying the function and purpose of the reference being modified.

Accordingly, reversal of the rejection of claim 9 under Section 103(a) over White, Watkins, and Robinson is warranted and is requested.

Ground 3

Ground (3) - whether claims 1, 3, 5, 6, 8, and 10-23 are unpatentable under 35 USC 103(a) over U.S. Patent 2,642,057- Watkins and U.S. Patent 1,779,507-White.

Appellant traverses this rejection of the claims in yet another "rather imaginative rationale advanced by the examiner," this time exchanging roles of the two references over that found in para. 2.

Like before, the examiner has again copied verbatim into para. 3, the previous remarks presented in para. 6 of the previous office action, without regard to the amended claims, and without regard to added claims 21-23. Claims 21-23 have been simply added to the list of claims being rejected without the due analysis thereof mandated by the MPEP.

As indicated above, both Watkins and White are nonanalogous art and disclose toy guns for shooting projectiles, which in the case of Watkins is a pea or pellet, and in the case of White is the entire 3-band assembly itself.

CLAIMS 1 and 17

1. An insect swatter 10 comprising:

an elongate rod 12 having a proximal end 12a for being hand-held, and an opposite distal end 12b for being aimed at an insect; and

an elastic lash 34 including only a pair of identical annular rubber bands 36,38 joined together at a knot 40 therebetween, and having a proximal end 18a fixedly joined and retained to said rod distal end 12b, and an opposite and loose distal end 18b sized for being elastically stretched from said rod distal end 12b to adjacent said rod proximal end 12a so that release of said lash distal end 18b spontaneously contracts said lash 34 for whipping said lash distal end 18b in extended striking range against said insect while said lash 34 is retained at said rod distal end 12b without disconnection therefrom.

17. An insect swatter 10 comprising:

an elongate rod 12 having a slot 30 at a distal end 12b thereof;

an elastic lash 34 configured in a figure eight with first and second knot-less loops 36,38 at opposite ends, and joined together at a knot 40 therebetween;

and

said lash first loop 36 is fixedly retained in said slot 30 to prevent disconnection therefrom when said lash 34 is whipped along said rod 12.

As for claims 1 & 17, the examiner has provided no evidence that all of the elements in these claims are found in Watkins, except for the quite significant pair of bands which solve many stated problems over the parent patent.

Fundamentally, neither Watkins nor White disclose any insect swatter at all; instead they disclose toy guns.

The examiner erroneously combines claims 1 & 17 for a pair of bands, when that pair is only recited in claim 1, while claim 17 recites a figure-8 lash with opposite loops.

And, the examiner erroneously concludes that "it would have been obvious to provide Watkins with a pair of rubber bands as shown in White for the purpose of extending range of the rubber band and/or reducing stress on the rubber bands since by using two the stress would be reduced."

This contention is clearly fabricated without regard to logic or common stress analysis, and is not supported by any evidence in these disparate references, and not based on legal motivation; and to the contrary, based solely on the examiner's reading of Appellant's own specification.

Remarkable indeed, is this latest line of rejection by the examiner, with equally imaginative rationale, divorced from reality and divorced from evidentiary and legal support.

How does the examiner propose to modify Watkins with the "pair of annular rubber bands" from White?

White discloses at pg. 1, ll. 87+, one, two, or three rubber bands for the purpose of using available old inner tire tubes.

White fails to explain any difference whatsoever between using one, two, or three bands, while any one of those configurations is preferred.

The only commonality of the 3-bands in White is their

convenience of fabrication from old inner tire tubes, and the corresponding sizes thereof for meeting the specific length of the long barrel 1.

If one old tube is big enough, then one would assume one band would be long enough.

If two smaller tubes were available, then it would also be assumed that two tubes could be combined into 2-bands for the requisite length.

And, if three yet smaller tubes were available, then it would also be assumed that three tubes could be combined into 3-bands for the requisite length.

Where then in Watkins or White does the examiner identify any "range" problem requiring a solution?

Where in Watkins or White does the examiner identify any "stress" problem requiring a solution?

No such problems are found in either reference, but, of course, the examiner has again used his imagination to fabricate those reasons, and a myriad of reasons could also be fabricated in hindsight, which the examiner has been quite adept at doing over the 12-year odyssey in prosecuting the parent application, and now this improvement application.

Both toy guns in Watkins and White appear to work quite well just as they are, and there is no problem disclosed in either reference for which the examiner's fabricated "solution" would be relevant.

This is yet another clear example of the examiner's prejudgment of the present application, and the examiner's continued drive to reject each and every claim for any reason whatsoever; notwithstanding the recent full reversal by the BPAI.

Let's assume that one skilled in the art would have a reason (any reason) to combine White with Watkins. What would that combination entail?

In Watkins, a single rubber band 14 is tied to the leather loop 16 in which the pea 20 is held for hurling.

So, let's replace that single band 14 with two bands from White; and then what do we have? Two bands with a connection 19, and then the leather loop 16 at the end of the two bands.

And, how is this relevant to claims 1 & 17?

Claim 1 requires that the lash have opposite ends specifically configured to function, with the distal end of the lash being available to swat an insect.

Yet, the loop 16 is required in Watkins; that loop 16 is leather not rubber, and the second band proposed by the examiner is intermediately located, and does not provide an opposite end of the 3-piece assembly.

This combination, apparently proposed by the examiner, lacks credulity and requires a gross distortion of the basic invention in Watkins.

Appellant is not required to speculate as to the examiner's proposed combination; MPEP 706.02(j) places the burden on the examiner to explain the combination and the legal basis therefor, now lacking in the examiner's overly simplistic fabrications.

As for claim 17, the 3-piece combination of Watkins and White proposed by the examiner clearly does not a figure-8 make; and the leather loop 16 in that combination is clearly not elastic.

Appellant need not further speculate as to the examiner's intentions in rejecting independent claims 1 & 17, since speculation is no basis to reject claims under Section 103; and the examiner's fabrications fail to comply with the specificity requirements of MPEP 706.02(j) and the legal motivation requirements of Ch. 2100.

"Extending the range," and "reduce the stress" are clearly not legal motivation, nor based on any evidence in either Watkins or White; and are both clearly erroneous assertions made without regard to technical accuracy.

The handgun in Watkins is short, the rifle in White is

long, so how could the long bands of White be substituted for the short band in Watkins, and why?

At pages 4 & 6 of the office action, the examiner finds in White relatively weak 3-bands for claim 19, which would correspondingly reduce the range of shooting the pea 20 in Watkins, but disregarding this teaching, the examiner simply contends to the contrary that the weaker series-bands when blindly applied to claims 1 & 17 would somehow be transformed to "extend the range" in defiance of the laws of physics.

"Reduce the stress." Where is this taught in the two references?

Would not the examiner's use of the bands and connections 19 of White increase stress, especially at the stress concentrations at the connections 19?

And, would not stretching those bands also increase stress. Why would multiple bands reduce stress in any manner, and where is the engineering support therefor?

The examiner's contentions are mere, bald assertions, made with the long practice of fabricating rejections in rote fashion without logical basis.

At page 3, the examiner previously argued "maximum stretchable length" for claim 15, and would not that teaching have increased, not decreased, stress?

Where then is the examiner's evidentiary or scientific support to "reduce stress?"

Furthermore, the expressly recited configurations of the insect swatters in independent claims 1 & 17 permit the free distal ends of the lashes to strike the insect in the manner of the conventional whip, while the lash is retained on the rod without disconnection.

In Watkins, the pea 20 is hurled, and therefore liberated from the toy gun, with no teaching that either the band 14 or leather loop 16 have any efficacy for swatting insects.

In White, the entire 3-bands are hurled from the toy

gun, yet again without any efficacy for swatting insects.

In both cases, it is highly unlikely that either toy gun could indeed function as an insect swatter.

CLAIM 3

3. A swatter 10 according to claim 1 further comprising:

a latch 20 pivotally joined adjacent to said rod proximal end 12a for releasably latching said lash distal end 18b; and

means 24, 20b for selectively releasing said latch 20 to release said lash distal end 18b for swatting said insect therewith.

For claim 3, the examiner admits that the pin 18 in Watkins does not "pivot," but no matter, let's just disregard the actual configuration of Watkins by substituting in whole the pivoting latch of White "for the purpose of a crisp release of the latch to increase the accuracy of the rubber band gun."

"Rather imaginative rationale" the BPAI previously attributed to the examiner. Without a doubt.

Why has the examiner taken this clear warning by the BPAI as license to continue that unwarranted practice of "imaginative rationale" to fabricate rejections without any regard to the actual facts or the actual references of record?

The Patent Rules mandate that the Appellant identify errors committed by the examiner in rejecting claims; and the errors are almost too numerous to identify and list.

See now the multiple-page length of this Brief in attempting to meet that requirement to identify errors.

We continue.

"Crisp release." "Increase accuracy."

Where in Watkins and White are problems presented for these "solutions" being proffered by the examiner?

The examiner has already attempted to modify Watkins to replace the band/leather 14,16. Now, the examiner proposes further modifying Watkins to substitute the entire firing mechanism from White for the pin 18.

Why not just complete that modification and substitute the entirety of White toy gun for Watkins gun and complete the transformation of Watkins into White? Why stop? Where stop?

There is no stopping the examiner in selecting naked elements from disparate references in fabricating rejections for each and every claim, no matter how specific or how unique any claim is.

The examiner's attempt to modify, and modify, and modify Watkins for reason after reason after reason is evidence in and of itself of the patentable novelty of Appellant's claims, no matter how simple they might be, and no matter that the applied references are quite ancient, and quite different.

The toy guns of Watkins and White are so fundamentally different from each other, it strains credulity to find any merit in the examiner's use thereof. The examiner is clearly using each of Appellant's claims, one by one by one, as the guide for the rejections under para. 3 as they are developed by the examiner from page 5 continuously to page 7, without even one break for a paragraph.

And, even if the pivoting latch of White were substituted for the pin 18 in Watkins, the resulting combination remains nevertheless a pea shooter. A simple pea shooter which requires the leather loop 16 to hold the pea 20 for hurling in a configuration having no relevance to any of Appellant's claims, let alone claim 3 being so rejected.

The pin 18 firing mechanism in Watkins has a specific configuration and a specific purpose which the examiner supplants by proposing the complete substitution from White, without cause or evidence.

CLAIM 5

5. A swatter 10 according to claim 3 further comprising:

a gun handgrip 14 fixedly joined to said rod proximal end 12a;

said latch 20 being pivotally joined to said handgrip 14; and

wherein said latch 20 releasing means 24, 20b includes a trigger 24 operatively joined to said latch 20 for releasing said latch 20 upon pulling said trigger 24.

Claim 5 recites the handgrip cooperating with the latch.

The examiner recognizes the handgrips in Watkins and White, and of course, the examiner opines that it would have been obvious to modify Watkins "for the purpose of leasing [twice incorrect spelling] the lash near the user's hand," whatever that means, which is not certain.

The examiner has yet again overlooked the combination recited in claim 5, and is continuing to build his rejections in a house-of-cards fashion without regard to the stability of that house, and without regard to the merits.

That house-of-cards should fall, as a result of this appeal (predicted in the last amendment), because the examiner must disregard the fundamental differences in Watkins and White to fabricate rejection after rejection on "imaginative rationale," now lacking even the color of propriety.

The combination in claim 5 provides a specific latch to mount the free, and loose, distal end of the lash for spontaneous contraction of the lash to swat the insect; while the opposite end of the lash is retained in the rod without disconnection.

The pea shooter in Watkins remains a pea shooter no matter how much the examiner chooses to change the specific

pin 18 configuration, without regard to the specific function and purpose and benefits thereof taught by Watkins.

No, just substitute the latch and handgrip from White for any purpose; yet the pea shooter of Watkins remains just a pea shooter, having no relevancy to Appellant's swatter, or claim 5, for example.

The examiner does not stop at claim 5, but continues.

CLAIM 6

6. A method of using the swatter 10 of claim 5 comprising:

stretching said lash 34 by pulling said distal end 18b thereof generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;

latching said lash distal end 18b to said latch 20;

gripping said handgrip 14 to aim said rod distal end 12b at said insect; and

pulling said trigger 24 to release said latch 20 to spontaneously contract said lash 34 for swatting said insect.

Claim 6 again recites a method to swat insects with the distal end of the lash; yet the examiner's remarks on page 5 of the office action simply assert that his proposed combination "performs all of the method steps recited" without indicating how that is done in Watkins which a pea shooter it is, and a pea shooter it remains.

At page 7, the examiner addresses White, not Watkins, and opines that "the fact that White [or Watkins apparently] does not disclose applicant's use is not material to article claims."

But, claim 6 is not an article claim; it is a method claim.

And, the examiner has presented no evidentiary support in either White or Watkins to support the rejection of method claim 6 or his McLaughlin contention of "only knowledge which

was within the level of ordinary skill."

In Watkins, the pea is shot away.

In White, the 3-bands are shot away.

The examiner has presented not one piece of evidence of using either Watkins or White in the manner specifically recited in claim 6; since there plainly is none. Only, bald examiner assertion.

CLAIM 21

21. An insect swatter comprising:
 an elongate rod 12 having a proximal end 12a, and
 an opposite distal end 12b for being aimed at an insect
 and including a keyhole slot 30;
 a gun handgrip 14 fixedly joined to said rod
 proximal end 12a;
 a latch 20 pivotally joined to said handgrip 14
 adjacent to said rod proximal end 12a;
 means 24, 20b for selectively releasing said latch
 20 and including a trigger 24 operatively joined to
 said latch 20 for releasing said latch 20 upon pulling
 said trigger 24;
 an elastic lash 34 including first and second
 annular rubber bands 36, 38 knotted together at an
 intertwined knot 40 therebetween;
 said first band 36 having a proximal end 18a
 forming a lash first loop 36 disposed through said
 keyhole slot 30 for fixedly retaining said lash 34 to
 said rod distal end 12b;
 said second band 38 having an opposite distal end
 18b forming a lash second loop 38 positionable around
 said latch 20 for being releasably retained thereby;
 and
 said lash 34 is sized for being elastically
 stretched from said keyhole slot 30 to said latch 20 so
 that release of said second loop 38 from said latch 20
 spontaneously contracts said lash 34 for swatting said
 second loop 38 against said insect.

Dependent claim 7 was canceled, without prejudice, and replaced by independent claim 21 which combines the relevant features of original claims 1, 3, 5, and 7.

Although the examiner has simply added claim 21 to the list of claims being rejected, the examiner has failed to

present any basis under Section 103 for the rejection thereof, which is therefore void ab initio.

As indicated above in part, White lacks any analogous latch 20 or cooperating releasing means 24,20b; lacks knotted together rubber bands 36,38; lacks the lash second loop 38 positionable around the latch 20; and lacks the recited cooperation in size of the lash 34 to stretch the opposite ends between the slot 30 and latch 20 for spontaneous contraction for swatting the second loop against the insect.

The examiner's rejection is silent on this combination of features since he has failed to update his previous analysis and remarks to address the amended and added claims, clearly prejudging any and all claims which this Appellant might present.

CLAIM 8

8. A method of using the swatter 10 of claim 21 comprising:

pulling said lash second loop 38 to stretch said lash 34 generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;

latching said lash second loop 38 around said latch 20;

gripping said handgrip 14 to aim said rod distal end 12b at said insect; and

pulling said trigger 24 to release said latch 20 to spontaneously contract said lash 34 for swatting said insect.

Method claim 8 has now been twice overlooked by the examiner, even though this was previously brought to his attention.

Claim 8 requires that the lash second loop is placed around the latch, and that second loop forms the opposite end of the lash.

In Watkins, the opposite end of the band/loop is the leather loop 16, and that loop is not placed around the pin

18.

In White, the opposite end of the 3-bands is placed around the extension 10, but there is no leather loop 16; and the right end of the 3-bands is not fixedly attached to the sight 4.

What then forms the evidentiary and legal basis to reject method claim 8 again overlooked by the examiner in his remarks?

CLAIM 9

9. A swatter 10 according to claim 21 wherein:
said latch 20 extends upwardly from said handgrip 14;
said keyhole slot 30 is open downwardly in a direction opposite to said upward extension of said latch 20 and loosely joins said lash 34 to said rod 12;
and
said lash 34 is inclined upwardly substantially straight from said keyhole slot 30 to said latch 20 when latched thereto, and said knot 40 is positioned atop said rod 12.

From claim 6, the examiner jumps to claim 9.

The examiner now recognizes the opposite configurations of the downward keyhole slot 30 recited in claim 9, and the upward slot 34 disclosed in Watkins.

But, the examiner disregards this difference by citing In re Japikse and merely stating that "no stated problem is solved."

It is interesting that the examiner uses the "no stated problem" contention to reject Appellant's claims, but the examiner conspicuously fails to identify any "stated problem" in the applied references when fabricating his "rather imaginative rationales" to reject the claims.

The examiner inherently recognizes that the legal motivation provisions found in ch. 2100 of the MPEP are indeed based on solving "stated problems," yet the examiner

disregards those provisions in order to fabricate rejections when combining disparate references because that is an examination expedient, and renders unwarranted those very rejections being proffered by the examiner.

Now, the examiner merely states that Appellant has not stated problems for which claim 9 would have significance.

This is clear error; and Appellant's specification indeed has many stated problems being solved, many of which are clearly found in the Background section, and repeated in the detailed description along with other problems.

As for claim 9, the keyhole slot 30 is introduced at para. 42, and described in detail in subsequent paragraphs.

Striking range and accuracy are two problems being solved, and the simple construction of the downward keyhole slot provides a loose joint to mount the lash proximal end without unintended liberation, and a smooth rod over which the lash and its knot must travel to reach the insect.

The upward slot 34 in Watkins interrupts the smooth surface of the barrel 10, which is not relevant therein because the band is used to propel the leather loop 16, which in turn hurls the pea 20.

The band 14 in Watkins must be fat and strong to catapult the pea 20, which are inapposite to the requirements of the double-band lash recited in claim 9 that requires thinness and flexibility to function as a whip since the distal end of the lash must be whipped as far as possible in the striking range to effectively swat insects without detection.

And, such a thin and flexible lash could inadvertently be abraded at the upward slot 34 of Watkins, or could inadvertently be released from that upward slot by forward inertia of the lash.

In claim 9, the slot is open downwardly, but the lash is loosely mounted in the slot and inclined oppositely and upwardly to therefore prevent any undesirable interaction

between the lash and the slot during the whipping method.

As for citing In re Japikse, that case does not hold what the examiner contends. Japikse relates to the mere rearrangement of parts; and the application of case law requires an initial showing of factual relevance overlooked by the examiner.

Also overlooked by the examiner is the fact that claim 9 depends on claim 21, and the substantial combination of elements recited therein.

In Japiske, an electrical switch was simply relocated.

But to reach claim 9, the examiner has made fabrication after fabrication after fabrication for many elements recited in claim 9. Claim 9 therefore is not the mere change of a single element, like the switch in Japiske.

Mere rearrangement of parts therefore has no relevance since the patentable novelty of claim 9 is not based on the mere orientation of the keyhole slot therein, be that up or down.

Has the examiner simply rearranged the slot 34 in Watkins to reject claim 9?

Of course not.

The examiner must first combine White with Watkins, and in that combination the examiner proposes many, many modifications.

After those initial modifications, the examiner then attempts to rearrange the slot 34 in Watkins as a mere rearrangement, when mere rearrangement it is clearly not.

The rejection of claim 9 by the examiner, is yet another example of the prejudgment of the claims and the failure by the examiner to afford any weight to the different combinations being recited, and their significant benefits expressly disclosed in the specification.

CLAIM 10

10. A swatter 10 according to claim 21 wherein:
said latch 20 is pivotable between a cocked position wherein said latch 20 extends generally perpendicularly to said rod 12 for retaining said lash second loop 38 thereon, and a fired position wherein said latch 20 is inclined forwardly toward said rod distal end 12b for allowing said lash second loop 38 to slip off said latch 20 for spontaneously contracting said lash 34; and
said trigger 24 is operatively joined to said latch 20 for releasing said latch 20 to pivot from said cocked position thereof to said fired position thereof upon pulling said trigger 24.

Claim 10 has also been overlooked by the examiner in his comments at page 6 of the office action, and therefore any rejection thereof is unwarranted.

Claim 10 recites the specific configuration of the perpendicular latch 20 and cooperating trigger 24.

In Watkins, the pin 18 triggering mechanism is fundamentally different both from claim 10 and from White.

Watkins requires the pin 18 and the slots 24,26 and the flexible handle 12 in a quite simple and effective combination in which the pin 18 is lowered by simple bending of the handle 12 to release the band 14 and fire the pea 20.

In spite of this simplicity, and in spite of there being no problem disclosed in Watkins with that effective triggering mechanism, the examiner apparently finds it obvious to substitute the entire triggering mechanism of White (see the examiner's rejection of claim 3) for that simple pin 18 combination.

Despite increasing the complexity and cost of the toy gun in Watkins, the examiner would find this obvious "for the purpose of a crisp release..." as proffered by the examiner under claim 3.

"Crisp release?" This, when the pin 18 of Watkins would already appear to be quite effective at achieving a "crisp release" to accurately shoot the pea 20.

Of course, the child using the pea shooter of Watkins

would find the "increased accuracy" proffered by the examiner advantageous.

This same examiner has rejected claim 9 with the allegation that Appellant has not stated any problem being solved. Yet, the examiner needs no statement of any problem to be solved in Watkins because it is much easier to fabricate problems in hindsight and disregard the requisite mandates of MPEP 706.02(j) and ch. 2100.

Yet, such disregard of the rules by the examiner can only lead to unwarranted rejections, and the many rejections proffered by the examiner suffer the same problems in lack of evidence, lack of analysis, lack of logic, and lack of legal motivation.

CLAIM 11

11. A swatter 10 according to claim 10 wherein said latch 20 includes a thumbgrip 28 extending generally perpendicularly therefrom for manually returning said latch 20 to said cocked position thereof.

The examiner continues with claim 11 which recites the cooperating thumbgrip 28.

And, the examiner simply applies the hammer 9 of White without any analysis or factual or legal showing whatsoever.

The examiner has failed to show any legal motivation to modify Watkins and replace the pin 18 triggering mechanism with that from White.

And, even if that were done it would appear quite certain that the extension 10 after pivoting forward would still project upwardly and interfere with the free flight of the leather loop 16 and pea 20 located behind the tie 37.

In that case, the loop 16 might become snagged on the extension 10, and the pea 20 would be shot at an inclination upwardly along the inclined extension 10, and severely reduce the accuracy of the toy gun for the child user, instead of

increasing the accuracy, which is the basic premise proffered by the examiner to combine the references in the first instance.

CLAIM 12

12. A swatter 10 according to claim 11 further comprising:

a spring 26 joined between said trigger 24 and said handgrip 14;

said trigger 24 being pivotable between a cocked position holding said latch 20 in said cocked position thereof, and a fired position releasing said latch 20 for pivoting said latch 20 to said fired position thereof; and

said spring 26 being positioned for providing a returning force on said trigger 24 to return said trigger 24 to said cocked position thereof upon release of said trigger 24.

For claim 12, the examiner simply identifies the spring 16 of White without any analysis or legal motivation, which clearly fails to meet even a prima facie showing.

As indicated above, there would be no good reason to replace the triggering mechanism of Watkins with that of White; and indeed, the introduction of the extension 10 from White would clearly interfere with the free movement of the leather loop 16 and pea 20 which must follow the band 14.

And, claim 12 has been addressed above in that neither spring 16 or 15 in White permits the trigger to return to the cocked position upon release of the trigger.

Return of the trigger 13 in White is blocked by the lever 7 until that lever 7 is returned to its initial position.

CLAIMS 13 & 14

13. A method of using the swatter 10 of claim 12 comprising:

cocking said thumbgrip to position said latch 20

into said cocked position thereof;
stretching said lash 34 by pulling said lash second loop 38 generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;
latching said lash second loop 38 around said latch 20;
gripping said handgrip 14 to aim said rod distal end 12b at said insect; and
pulling said trigger 24 to release said latch 20 to said fired position thereof to spontaneously contract said lash 34 for swatting said insect.

14. A swatter 10 according to claim 10 wherein:
said lash 34 has an unstretched length;
said rod 12 and latch 20 have a collective cocked length measured between said keyhole slot 30 and said latch 20 in said cocked position thereof; and
said cocked length is selected for stretching said lash 34 to about its maximum stretchable length without breaking thereof.

The examiner has yet again overlooked claims 13 & 14, and therefore no prima facie showing has been made, and Appellant need not speculate as to what the examiner intended, when, of course, there is no plausible combination of Watkins and White relevant to these claims.

Claim 13 recites a specific method, and like the previous method claims addressed above, the examiner has provided no evidence that the toy guns in Watkins and White would have been used to swat insects; not does either toy gun use any whipping action to whip the distal end of a lash against an insect.

In Watkins, the pea 20 is hurled away; and in White, the 3-bands are hurled away, and no whipping method is contemplated by either reference.

In claim 13 the thumbgrip is cocked, the lash stretched and loaded, the handgrip aimed, and the trigger pulled to swat the insect.

In Watkins the band is mounted on the pin 18 to hurl the pea from the leather pouch 16.

No modification of Watkins can change its basic method of "intended" use, and clearly the examiner's attempt to somehow modify Watkins based on White is not supported by legal motivation, and does not suggest the different method recited in claim 13.

Claim 14 recites the respective unstretched and collective lengths for achieving maximum stretch without breaking.

Neither reference Watkins nor White has any relevant teaching; with Watkins requiring a strong, fat band 14 to propel the pea 20, and White requiring old tire tube bands to loosely fit the length of the long barrel 1.

CLAIM 15

15. A swatter 10 according to claim 10 wherein:
said lash 34 has an unstretched length L1;
said rod 12 and latch 20 have a collective cocked length L2 measured between said keyhole slot 30 and said latch 20 in said cocked position thereof; and
said cocked length L2 is at least three times said lash 34 unstretched length L1 and said lash 34 has a striking range R greater than twice said unstretched length L1.

For claim 15, the examiner merely opines that it would have been obvious to have the cocked length in Watkins at least three times the unstretched length for "more energy" and "range," and references Watkins at col. 3, ll. 29-37.

However, the examiner has failed to afford due weight to claim 15 and the problems being solved and the advantages; and the examiner has failed to evaluate Watkins and White in the whole.

The examiner has overlooked that the examiner himself has already modified the single band 14 in Watkins by doubling it in length in accordance with White.

However, inherent in the doubling of that band 14 is the reduction by 50% of the spring rate thereof (see para. 62

of Applicant's specification). See also the examiner's own inconsistent comments regarding claim 19 on page 6 for the reciprocal, and therefore smaller, spring rate.

Halving the spring rate would therefore halve the energy and effectively halve the range of propelling the pea 20.

But, the examiner has merely argued without scientific basis that the double-band modification of Watkins would increase stored energy and increase range, and in particular get those increases with the triple length recited. Clearly, the examiner has been trapped by his own distorted logic, and the blind evaluation of naked claims without regard to the whole, and without any regard to common engineering principles.

Claim 15 is quite specific: at least three times the unstretched length, and was also amended for the effective striking range being greater than twice the unstretched length.

Section 103 mandates equally specific teaching based on evidence in a reference, clearly not provided by the examiner in the rush to reject even the most specific claim of the group.

Where then is any objectivity being shown in the examiner's examination of the twenty claims, if even the most specific feature will not be afforded any weight by the examiner?

Watkins shows a fat, strong, single band 14 specifically configured to hurl the pea 20.

White shows three bands in a train, which would have a resultant stiffness of about $1/3$ the individual stiffnesses, if equal; and two equal bands would have $1/2$ the stiffness.

To increase the number of bands 14 in Watkins would therefore be contrary to the examiner's own "rather imaginative [and erroneous] rationale" found at page 6 of the office action because more bands in series in Watkins would

decrease the stored energy and range of the toy gun.

This latest error by the examiner has fundamental bearing on independent claims 1 & 17 as well for which the examiner simply opines that Watkins would have been so modified for increasing its range, when, to the contrary, the range would be reduced.

To increase the number of bands 14 in Watkins would also be against the very teachings of Watkins itself.

The examiner cites col. 3, ll. 29-37, which specifically teaches that any rubber band could be used with "length somewhat shorter than the barrel 10." "Generally speaking, the shorter the length of the band ..., the greater the impetus given to the projectiles shot by the gun."

"Somewhat shorter" does not give the examiner license to reject claim 15 in which the lash is over two-thirds ($2/3$) shorter than the cocked length.

And, "Generally speaking" does not give such license either.

Overlooked by the examiner, yet again, is the whole teachings of Watkins and White, and the whole of claim 15.

In Watkins, the band 14 is single to maximize its spring rate, which would be correspondingly diminished if modified in series.

In Watkins, the band 14 is thick and fat, see most of the figures, because a thick fat band, irrespective of length can store more energy to hurl the pea.

The length of the band 14 in Watkins is less important than its other properties, "Generally speaking," because that band 14 must be specifically configured to cooperate with the leather loop 16 to hold the pea 20 and hurl it.

In White, the length of the 3-bands is quite irrelevant to Watkins, because the 3-bands in toto are being hurled and face different problems, and would therefore require different characteristics in the 3-bands.

And, in claim 15 the double bands have opposite ends

between which determines their length and which are differently mounted to the common rod for effecting the desired whipping function.

In whipping, the elasticity of the bands is important but competes with swatting energy. See para. 7 of the Background for competing considerations.

Para. 48 explains the specific advantages of the claim 15 configuration, neither disclosed nor suggested by the two disparate references Watkins and White.

CLAIM 16

16. A swatter 10 according to claim 14 wherein said first and second bands 36,38 have equal lengths to position said knot 40 midway between said cocked length L2 thereof.

As for claim 16, the examiner admits the failures of Watkins and White, but "at any rate, it would have been obvious ... for the purpose of extending the range of the rubber band gun."

However, as indicated above, using "two or three knotted rubber bands" as the examiner now contends, would, to the contrary, decrease the firing range of Watkins and not increase that firing range because less energy could be stored in those two or three bands arranged in the series shown in White.

However, the examiner should recognize that if two or three bands were instead mounted in parallel in Watkins, then more energy could be stored in those parallel bands, and indeed increase the range of the rubber band gun.

But, claim 16 (and claim 21 from which it depends) does not recite the use of parallel bands, and the examiner has been caught in his own contradictions.

As indicated above, the three bands of White have different lengths, 41/37/35 mm, and the examiner's mere

statement of equal lengths is not supported by the evidence.

And, the examiner's mere statement of not-to-scale does not recognize either the relative dimensions clearly illustrated in the figures of White, for which actual scale is irrelevant; or the written description of White which explains the crude fabrication of the bands from old tire tubes which would render impossible the specific configuration recited in claim 16.

And, whether two or three bands from White are substituted for the single band 14 in Watkins, the examiner has again overlooked the essential leather loop 16 which defines one of the two opposite ends of the combined train.

The examiner has not shown how it could even be possible to place one connection 19 or the second connection 19 in the combined band/loop train of Watkins midway between the cocked length of first and second bands when cocked in Watkins.

CLAIM 17

Regarding independent claim 17, the examiner has only briefly addressed it in passing at the beginning of para. 3, and without regard to the different elements recited therein, instead addressing only the elements of claim 1.

Accordingly, the examiner has failed to establish even a prima facie showing for claim 17.

As indicated above, claim 17 recites an insect swatter in contradistinction from the toy guns disclosed in Watkins and White.

Claim 17 recites a lash having a figure-eight configuration, with opposite first and second loops.

The single band 14 in Watkins lacks any figure-eight configuration, and the leather loop 16 is tied to one end thereof.

Claim 17 also recites that the first loop is retained

in the slot 30 at the end of the rod 12.

In White, the 3-bands necessarily are temporarily held on the sight 4 and the extension 10; no slot.

The examiner's reason to combine Watkins and White is mere conclusion as indicated above, and lacks evidentiary basis and lacks legal motivation.

And, even the reason proffered by the examiner in hindsight is erroneous since substituting two or three bands from White for the single band 14 of Watkins would correspondingly reduce the collective spring rate and stiffness thereof, and reduce the available energy for propelling the pea 20, and would correspondingly reduce the accuracy of shooting due to the slower propelled pea.

As for reducing stress on double bands in Watkins, neither reference indicates that stress is a problem, and the examiner has inherently admitted in his contentions regarding claim 15 that it would be obvious to stretch the bands to their maximum limit to increase stored energy, and therefore the increased stress would not appear to be a problem to the examiner himself, or to the inventors in Watkins and White.

Clearly, the examiner simply fabricates reasons to combine the references for the different claims based on perfunctory habit, regardless of merit or evidence, without regard to consistency, and without regard to the whole, and without regard to specific problems taught by the references for which the different solutions thereof might have some relevance.

CLAIM 18

18. A swatter according to claim 17 further comprising:

 a handgrip 14 fixedly joined to a proximal end 12a of said rod 12 opposite from said distal end 12b thereof;

 a latch 20 pivotally joined to said handgrip 14 adjacent to said rod proximal end 12a for releasably

latching said lash second loop 38; and
a trigger 24 operatively joined to said latch 20
for releasing said latch 20 upon pulling said trigger
24.

Claim 18 has again been overlooked by the examiner and introduces the handgrip 14, latch 20, and trigger 24 in a specific combination not previously addressed by the examiner.

Watkins clearly teaches the use of the special pin 18 and flexible handle 12 in significant distinction from the complex triggering mechanism of White.

As indicated above, should the examiner propose to substitute the extension 10 from White for the pin 18 in Watkins, then that extension would clearly interfere and obstruct the free movement of the leather loop 16 and pea 20 as they travel forward over that extension 10.

The pea 20 would no doubt be deflected outwardly along the extension 10 in the manner of a ski slope, and would destroy the accuracy of flight of the pea 20.

CLAIM 19

19. A swatter according to claim 18 wherein said lash 34 includes a pair of annular rubber bands 36,38 joined together in series at said knot 40, and having a collective spring rate equal to one-half the spring rate of either band.

As for claim 19, the examiner states that the two or three bands from White substituted for the single band 14 in Watkins would inherently meet the reciprocal spring rate recitation, but has again omitted not only the requisite legal motivation, but has overlooked the amendment made to this claim.

Claim 19 now recites the species of one-half spring rate for the two bands, and it would be impossible to obtain

this spring rate from the single band 14 in Watkins, or substituting two of the 3-bands from White because those two bands would inherently be different in size.

As indicated above, and the examiner himself contends that the single band 14 in Watkins is used to store energy to propel the pea 20. And, by substituting two or three bands from White, the energy storing capability is halved or even reduced by two-thirds for identical bands, which in turn would severely reduce the energy storing capability of the so modified band 14.

This combination proposed by the examiner is clearly against the fundamental teachings of Watkins, and is clear evidence of the nonobviousness of Appellant's claims.

CLAIM 20

20. A swatter according to claim 18 wherein said pair of rubber bands 36,38 are identical in size, cross section, and material composition, and have equal lengths to position said knot 40 midway between said first and second loops 36,38.

As for claim 20 and its identical bands, the examiner nevertheless simply contends that this would be obvious "since the function is the same and no showing of criticality was made."

Appellant's specification is replete with the significance of using series bands for the lash; and the benefits thereof; and the special advantages of identical bands.

"No criticality?"

Firstly, claim 20 depends from claims 18 and 17, and is a combination claim.

The examiner has not cited any provision of the MPEP or case law which requires any "criticality" at all, and the use of this basis is nothing more than perfunctory examiner

edict.

And, to the contrary, "criticality" has indeed been shown in the specification, but intentionally overlooked by the examiner, notwithstanding the previous identification thereof.

The examiner has clearly failed to afford any weight to the specification, its special problems, and its special solutions in improving the single-band lash of the parent application (and patent) into plural series bands for special benefit.

"No criticality" is nothing more than express admission that the examiner has not evaluated the specification at all, let alone in the whole.

The "criticality" is based on the problems observed in the single band swatter of the parent patent; and the entire application is specifically written in that regard.

The application identifies those problems, introduces the solution in the series lash; and then explains the function, performance, and benefits.

How is it possible that the examiner has missed this description in the specification in direct support of all claims, and in particular claim 20?

The answer is that the examiner has not evaluated Appellant's claims in the whole, but in the naked vacuum of each claim without regard to context of its parent claims, and without regard even to the specification.

"The function is the same," the examiner opines?

To be certain, the projectile-shooting functions in Watkins and White are not the same as the whipping function in Appellant's claims.

In Watkins, the band 14 is configured to cooperate with the leather loop 16 to shoot the pea 20.

In White, the 3-bands are made from old tire tubes, and configured to be shot in toto.

Where is the "same function?"

In claim 20, the two bands would have one-half the stiffness of a single band for the benefits disclosed in the specification, including increased striking range of the whip which is not used to shoot peas.

The use of two bands 14 in Watkins would halve the energy storage capability of those bands to reduce the range of the pea 20.

"Same function?"

Para. 61 states that the midway knot 40 uses the rod itself to guide the lash during swatting, and that swatting has accuracy of direction for swatting the distal end of the lash against the insect.

CLAIM 22

22. A swatter according to claim 3 wherein said rod 12 and latch 20 have a collective length L2 from the juncture of said lash proximal end 18a and said rod distal end 12b which is at least three times the unstretched length L1 of said lash 34.

Since the examiner has simply copied verbatim the rejections in para. 3, his comments stop at page 7 with claim 20, and fail to address added claims 21-23, rendering void ab initio this rejection for want of evidence and legal analysis.

Independent claim 21 has been addressed above.

Claim 22 recites the at least three times stretching capability of the two-band species of the lash 34 for the considerable benefits presented in the specification, and addressed above.

At page 6 in reference to claim 15, the examiner admits that Watkins and White do not disclose this feature, but simply opines that the bands in White could be so stretched to increase energy storage and increase range.

What the examiner overlooks is his fundamental premise

that the strong, fat band 14 of Watkins already has large energy storage capability for long range of pea shooting.

But then the examiner has replaced that strong, fat band 14 with two or more short and thin bands from the 3-bands disclosed by White, and made that replacement in series.

Accordingly, the series chain of bands so modified by the examiner himself, inherently have less energy storage capability, and less pea shooting range.

The examiner's bald contentions therefore continue to defy even basic logic or common engineering principles, all in the routine fabrication of rejections before the PT0.

The examiner himself recognizes that the 3-bands in White are formed from old tire tubes.

How would it even be possible that even by chance they could meet the special limitation of claim 22?

It is not possible.

The two-bands in series recited in claim 22 require special configuration conforming to the recited rod for effecting the recited three-times stretching for the intended striking range, quite relevant to the whip, but quite irrelevant to the pea-shooting toy gun of Watkins.

CLAIM 23

23. A swatter according to claim 5 wherein said handgrip 14 includes a latch stop 22c adjacent to said latch 20 for limiting rotation thereof when said stretched lash 34 pulls said latch 20 into spontaneous abutment with said stop 22c as said lash distal end 18b is released from said latch 20 to spontaneously contract said stretched lash 34.

Claim 23 was added to replace method claim 4 and depends from claim 5.

In this species, the latch stop 22c from paras. 35 & 39 is introduced adjacent to the latch 20, and under spontaneous

contraction of the duplex lash, the latch spontaneously abuts the stop and adds forward inertia in maintaining the line-of-sight aiming at the intended insect. In other words, the insect swatter goes "BANG" and the swatting results are improved.

Such "bang" is a mechanical effect occurring simultaneously with the release of the lash and improves swatting performance, not found in the simple hand release of the lash without the recited firing mechanism.

The specification explains in detail the special configuration of the insect swatter and its constituent parts in substantially improved performance, for which the examiner has afforded no weight, perhaps as mere "intended use," but the "whole" analysis dictates otherwise.

Claim 23 does not recite a latch stop in a vacuum.

Claim 23 depends from claims 5, 3, and 1.

At page 5 for claim 3, the examiner appears to simply substitute the extension 10 from White for the pin 18 of Watkins.

Also at page 5 for claim 5, the examiner appears to simply substitute the trigger 13 from White in some unexplained combination in Watkins.

Such lack of specificity and speculation cannot support any rejection under Section 103.

The examiner must first use the extension 10 in White for the recited latch.

The examiner must also use the trigger 13 in White.

But, claim 23 introduces yet another element, the latch stop 22c adjacent to the latch; and the latch stop is a different element than the cooperating latch and trigger.

The stop 22c, shown in figure 3, limits rotation of the latch 20 when the lash is fired, and then the latch is pulled by the fired lash into spontaneous abutment (Bang) with the stop.

At page 4 for the Ground 1 rejection, the examiner

simply contends that the "latch stop 14 [in White] ... prevents the latch 10 from moving until the trigger 13 is pulled."

The examiner has not provided any such support under the Ground 3 rejection, but such support is nevertheless irrelevant to claim 23.

The extension 14 in White is part of the trigger 13, and moves only when the trigger is pulled. It then releases the extension 10 to release the 3-bands.

Claim 23 could not be any more different than the triggering mechanism in White, or in Watkins, and the extension 14 in White clearly does not have any effect to stop the extension 10 when, instead, it is released by the trigger extension 14.

The examiner has identified no relevant triggering mechanism in the main reference Watkins under his reverse rejection now combining White as the secondary reference.

Why then has the examiner chosen to overlook even the species of added claim 23?

All twenty claims, including amended and added claims, has the examiner rejected, all twenty. This, even following a full reversal by the BPAI clearly noting the examiner's "rather imaginative rationale."

To be certain, the next BPAI may be surprised by the further imaginative rationale of the examiner shown in the latest two office actions following the first appeal in this improvement application, without regard to consistency, in rejecting each and every one of those twenty claims based on multiple references, multiple combinations, and multiple conclusions without regard to the references in the whole, or the essential requirement of legal motivation.

Accordingly, reversal of the rejection of claims 1, 3, 5, 6, 8, and 10-23 under Section 103(a) over Watkins and White is warranted and is requested.

CONCLUSION

Although Appellant has traversed the multiple rejections of each and every claim on the individual merits of the different combinations thereof, the Board may choose to reverse all rejections quite simply.

The three applied references White, Watkins, and Robinson are clearly nonanalogous art.

Those three references disclose different toy guns having different problems from each other, and different from Appellant's stated problems.

And, quite significant is the fundamental or basic configurations of each and every one of those three references in which projectiles are shot or catapulted or fired away from the guns, in intentional liberation therefrom.

What is a whip?

Appellant's claims expressly recite an insect swatter apparatus specifically configured to perform or function as a whip.

Intended use the examiner would argue?

No, the lash is specifically affixed at one end only to the recited rod, leaving the other end free so that it may be stretched during use and cocked, and then fired to swat an insect in whip fashion with the fixed end remaining connected to the rod.

Specific method claims cover the process, but do not negate the special configuration of the insect swatter for indeed functioning as a whip.

The "whole" analysis mandates that the examiner afford due weight to each and every claim feature in the whole, and that includes its function, use, and purpose due in fact from the combination of elements recited.

Combination elements may not be disregarded, as this examiner has done, under the guise of mere intended use, and

the relevant case law so holds.

The issue of a positive limitation or mere intended use is addressed in *Kropa v. Robie and Mahlman*, 187 F.2d 150, 152, 88 USPQ 478, 480-481 (CCPA 1951) as follows:

This court has often had before it the Jepson problem [citation omitted] - whether the preamble to claims in ex parte cases or to the counts in interference cases should be considered as limitations in the claims or counts. Of the thirty-seven cases of this court we have reviewed with respect to this problem it appears that the preamble has been denied the effect of a limitation where the claim or count was drawn to a structure and the portion of the claim following the preamble was a self-contained description of the structure not depending for completeness upon the introductory clause; or where the claim or count was drawn to a product and the introductory clause merely recited a property inherent in the old composition defined by the remaining part of the claim.

In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of that subject matter. On the other hand, in those ex parte and interferences cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or counts. In the latter class of cases, the preamble was considered necessary to give life, meaning, and vitality to the claims or counts. Usually, in those cases, there inhered in the article specified in the preamble a problem which transcended that before prior artisans and the solution of which was not conceived by or known to them. The nature of the problem characterized the elements comprising the article, and recited in the body of the claim or count following the introductory clause so, as to distinguish the claim or count over the prior art.

Each claim recites an insect swatter in the preamble for the apparatus claims, and a method of use for the process claims.

Each claim includes various elements in combination, and those elements cooperate in the claim bodies with

particular configurations relevant to the recited function in swatting insects.

Of course, any one of the toy guns disclosed in White, Watkins, and Robinson could or might be aimed at an insect, but nevertheless those three toy guns are fundamentally different from each other, and each hurls a different form of projectile, be it at an insect or not.

The examiner rejects the various claims based in part on mere "intended use," but fails to afford any weight to the structural elements recited therein and their functional cooperation in combination.

The examiner's many rejections are nothing more than the recognition that almost all combinations of elements are made from constituent parts, and it is only sufficient for this examiner to find those parts in various references, and simply contend, in bald hindsight, that it would have been obvious to combine them in the manner of Appellant's claims.

No patent application would ever issue under this subjective, and clearly erroneous application of Section 103 being proffered by the examiner.

In White, the 3-bands are shot away in whole, no whipping configuration at all.

In Watkins, the pea is shot away using the specially configured leather pouch and attached band, with yet again no whipping action for the singular propulsion band.

And, in Robinson the single cord is used to shoot the ball, with yet again no whipping action.

The examiner has first combined White as the primary reference under Ground 1, with Watkins being the secondary reference.

And, then the examiner has reversed the order of references under Ground 3 using Watkins as the primary reference and White as the secondary reference.

In this way, the examiner is attempting to reject all claims using "belt and suspenders" and all possible

permutations, except, of course, applying Robinson as the primary reference.

This the examiner does in shotgun approach because perhaps this Board of Appeals will finally sustain some rejection from one of the shotgun pellets being applied.

It is noted that in the parent application, prosecution was reopened by the same examiner, Rowan, following the full reversal of all rejections, not based on any newly uncovered references, but using references already of record.

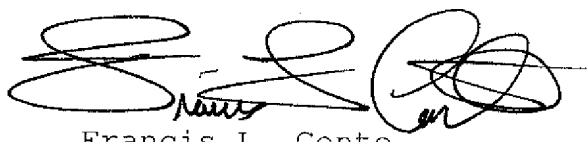
Perhaps in this application this examiner has exhausted all references of record and all possible combinations thereof, and perhaps the prosecution of this application will not again be so reopened in the event this Board again reverses this examiner.

When will this prosecution end?

It is sincerely hoped that this Board will yet again appreciate the erroneous application of the irrelevant art, and yet again fully reverse these latest rejections of all pending claims.

For these exemplary reasons, reversal of all the various rejections is warranted, and allowance of all remaining claims 1, 3, 5, 6, and 8-23 is warranted and is requested.

Respectfully submitted,



Francis L. Conte

Date: 30 March 2007

6 Puritan Avenue
Swampscott, MA 01907
Tel: 781-592-9077
Fax: 781-592-4618

Attachments:

1. Claims Appendix
2. Evidence Appendix
3. Related Proceedings Appendix

CLAIMS APPENDIX

Claims on appeal:

1. An insect swatter comprising:

an elongate rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect; and

an elastic lash including only a pair of identical annular rubber bands joined together at a knot therebetween, and having a proximal end fixedly joined and retained to said rod distal end, and an opposite and loose distal end sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for whipping said lash distal end in extended striking range against said insect while said lash is retained at said rod distal end without disconnection therefrom.

3. A swatter according to claim 1 further comprising:

a latch pivotally joined adjacent to said rod proximal end for releasably latching said lash distal end; and

means for selectively releasing said latch to release said lash distal end for swatting said insect therewith.

5. A swatter according to claim 3 further comprising:

a gun handgrip fixedly joined to said rod proximal end;

said latch being pivotally joined to said handgrip; and

wherein said latch releasing means includes a trigger operatively joined to said latch for releasing said latch upon pulling said trigger.

6. A method of using the swatter of claim 5 comprising:

stretching said lash by pulling said distal end thereof generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;

latching said lash distal end to said latch;
gripping said handgrip to aim said rod distal end at said insect; and
pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

8. A method of using the swatter of claim 21 comprising:

pulling said lash second loop to stretch said lash generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;
latching said lash second loop around said latch;
gripping said handgrip to aim said rod distal end at said insect; and
pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

9. A swatter according to claim 21 wherein:

said latch extends upwardly from said handgrip;
said keyhole slot is open downwardly in a direction opposite to said upward extension of said latch and loosely joins said lash to said rod; and
said lash is inclined upwardly substantially straight from said keyhole slot to said latch when latched thereto, and said knot is positioned atop said rod.

10. A swatter according to claim 21 wherein:

said latch is pivotable between a cocked position wherein said latch extends generally perpendicularly to said rod for retaining said lash second loop thereon, and a fired position wherein said latch is inclined forwardly toward said rod distal end for allowing said lash second loop to slip off said latch for spontaneously contracting said lash; and
said trigger is operatively joined to said latch for releasing said latch to pivot from said cocked position thereof to said fired position thereof upon pulling said

trigger.

11. A swatter according to claim 10 wherein said latch includes a thumbgrip extending generally perpendicularly therefrom for manually returning said latch to said cocked position thereof.

12. A swatter according to claim 11 further comprising:
a spring joined between said trigger and said handgrip;
said trigger being pivotable between a cocked position holding said latch in said cocked position thereof, and a fired position releasing said latch for pivoting said latch to said fired position thereof; and
said spring being positioned for providing a returning force on said trigger to return said trigger to said cocked position thereof upon release of said trigger.

13. A method of using the swatter of claim 12 comprising:
cocking said thumbgrip to position said latch into said cocked position thereof;
stretching said lash by pulling said lash second loop generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;
latching said lash second loop around said latch;
gripping said handgrip to aim said rod distal end at said insect; and
pulling said trigger to release said latch to said fired position thereof to spontaneously contract said lash for swatting said insect.

14. A swatter according to claim 10 wherein:
said lash has an unstretched length;
said rod and latch have a collective cocked length measured between said keyhole slot and said latch in said cocked position thereof; and

said cocked length is selected for stretching said lash to about its maximum stretchable length without breaking thereof.

15. A swatter according to claim 10 wherein:

said lash has an unstretched length;

said rod and latch have a collective cocked length measured between said keyhole slot and said latch in said cocked position thereof; and

said cocked length is at least three times said lash unstretched length and said lash has a striking range greater than twice said unstretched length.

16. A swatter according to claim 14 wherein said first and second bands have equal lengths to position said knot midway between said cocked length thereof.

17. An insect swatter comprising:

an elongate rod having a slot at a distal end thereof;

an elastic lash configured in a figure eight with first and second knot-less loops at opposite ends, and joined together at a knot therebetween; and

said lash first loop is fixedly retained in said slot to prevent disconnection therefrom when said lash is whipped along said rod.

18. A swatter according to claim 17 further comprising:

a handgrip fixedly joined to a proximal end of said rod opposite from said distal end thereof;

a latch pivotally joined to said handgrip adjacent to said rod proximal end for releasably latching said lash second loop; and

a trigger operatively joined to said latch for releasing said latch upon pulling said trigger.

19. A swatter according to claim 18 wherein said lash includes

a pair of annular rubber bands joined together in series at said knot, and having a collective spring rate equal to one-half the spring rate of either band.

20. A swatter according to claim 18 wherein said pair of rubber bands are identical in size, cross section, and material composition, and have equal lengths to position said knot midway between said first and second loops.

21. An insect swatter comprising:

- an elongate rod having a proximal end, and an opposite distal end for being aimed at an insect and including a keyhole slot;

- a gun handgrip fixedly joined to said rod proximal end;

- a latch pivotally joined to said handgrip adjacent to said rod proximal end;

- means for selectively releasing said latch and including a trigger operatively joined to said latch for releasing said latch upon pulling said trigger;

- an elastic lash including first and second annular rubber bands knotted together at an intertwined knot therebetween;

- said first band having a proximal end forming a lash first loop disposed through said keyhole slot for fixedly retaining said lash to said rod distal end;

- said second band having an opposite distal end forming a lash second loop positionable around said latch for being releasably retained thereby; and

- said lash is sized for being elastically stretched from said keyhole slot to said latch so that release of said second loop from said latch spontaneously contracts said lash for swatting said second loop against said insect.

22. A swatter according to claim 3 wherein said rod and latch have a collective length from the juncture of said lash proximal end and said rod distal end which is at least three

times the unstretched length of said lash.

23.A swatter according to claim 5 wherein said handgrip includes a latch stop adjacent to said latch for limiting rotation thereof when said stretched lash pulls said latch into spontaneous abutment with said stop as said lash distal end is released from said latch to spontaneously contract said stretched lash.

EVIDENCE APPENDIX

In accordance with 37 CFR 41.37(c)(1)(ix), there is no additional evidence submitted by the Appellant pursuant to 37 CFR 1.130, 1.131, or 1.132, or any other evidence entered by the examiner and relied upon by Appellant, other than the evidence relied upon by the examiner as to the grounds of rejection to be reviewed on appeal.

RELATED PROCEEDINGS APPENDIX

Attached are copies of related decisions rendered by the court or by the Board.

1. Decision by BPAI on Appeal No. 96-3971, dated 22 Sep 1998
2. Decision by BPAI on Appeal No. 2000-2033, dated 20 Sep 2001
3. Judgment by CAFC on Fed. Cir. Appeal No. 02-1150, dated 5 Jun 2002
4. Decision by BPAI on Appeal No. 2006-0635, dated 9 Mar 2006

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS L. CONTE

Appeal No. 96-3971
Application 08/331,851¹

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, and
MEISTER and PATE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 4-15. The invention is directed to an insect swatter and method of using such a swatter. The swatter uses a rubber band as an elastic lash to strike an insect.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

¹ Application for patent filed October 31, 1994.

MAILED

SEP. 22 1998

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 96-3971
Application 08/331,851

1. An insect swatter comprising:

an elongated rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect;

an elastic lash in the form of an annular rubber band having a proximal end forming a first loop fixedly joined to said rod distal end, and also having an opposite distal end forming a second loop, said lash being sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for swatting said lash distal end against said insect;

a latch pivotally joined adjacent to said rod proximal end for releasably latching said lash distal end so that said second loop is positioned around said latch for being retained thereby; and

means pivotally joined adjacent to said latch for selectively releasing said latch to release said lash distal end for swatting said insect therewith.

The references relied on by the examiner are:

Watkins	2,642,057	June 16, 1953
Zaremba	4,774,786	Oct. 4, 1988

The examiner has rejected claims 1 and 4-15 under 35 U.S.C. § 103 as unpatentable over Zaremba in view of Watkins. According to the examiner, the patent to Zaremba shows an insect swatter with all the elements recited in claim 1 with the exception of the rubber band with first and second loops. The examiner is further of the opinion that Watkins shows such a rubber band. Therefore, it is the examiner's conclusion that it would have been obvious to provide Zaremba with a looped rubber band as shown by Watkins since "the function is the same and no unexpected results were made."

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the determination that the applied prior art does not provide the evidentiary basis for a *prima facie* case of obviousness. Accordingly, we reverse the rejection on appeal.

We note that claim 1, and consequently all claims on appeal, includes the limitation of a latch pivotally joined to said rod proximal end for releasably latching said lash and also includes a means pivotally joined adjacent to said latch for releasing said latch. A close review of the applied prior art of Zaremba and Watkins clearly reveals that neither patent provides evidence of a latch and a means pivotally joined adjacent to said latch selectively releasing said latch. Therefore, we are in agreement with the appellant's arguments on page 12 of the brief that the examiner has failed to address the additional recited elements of claim 1 including the latch 20 and the separate releasing means 24 and 26.


We are in agreement with the appellant that the claim requires two pivoted components--latch 20 and means 24 and 26. The examiner points to the latch and the releasing means of Zaremba which are disclosed clearly as being a single element. Since the claim requires two separate elements and Zaremba discloses only one,

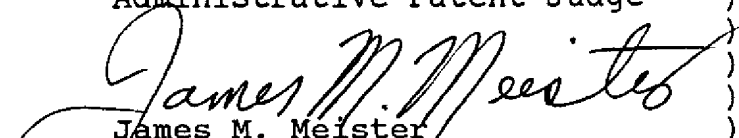
Appeal No. 96-3971
Application 08/331,851


the combined teachings of Zaremba and Watkins fail to establish a *prima facie* case of obviousness.

The rejection of claims 1 and 4-15 is reversed.

REVERSED


Harrison E. McCandlish, Senior)
Administrative Patent Judge)


James M. Meister)
Administrative Patent Judge)


William F. Pate, III)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 96-3971
Application 08/331,851

Francis L. Conte
6 Puritan Avenue
Swampscott, MA 01907

WFP/cam

9/23/01

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS L. CONTE

MAILED

Appeal No. 2000-2033
Application 08/331,851

SEP 20 2001

ON BRIEF

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before PATE, STAAB, and McQUADE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is the second appeal of the final rejection of claims 1 and 4 through 15. Claims 2 and 3 have been canceled. These are all the claims in the application.

In a first *ex parte* appeal, this board rendered a decision on September 22, 1998 reversing all rejections of claims 1 and 4 through 15. Subsequent to the appeal the examiner reopened

Appeal No. 2000-2033
Application 08/331,851

prosecution under 37 CFR § 1.198 and rejected all claims on art previously of record. The applicant petitioned under 37 CFR § 1.181 contending, *inter alia*, that the reopened prosecution failed to comply with 37 CFR § 1.198. In a petition decision rendered on May 21, 1999, applicant's petition was denied. Thereafter, the examiner issued a third office action rejecting all claims. On June 3, 1999, the applicant again filed a petition challenging the propriety of the reopened prosecution. Applicant subsequently filed a Notice of Appeal, and the petition was denied. Thereafter, applicant filed a brief and the examiner submitted an examiner's answer, and the case comes to us as a normal *ex parte* appeal.

The claimed subject matter is directed to an insect swatter which uses an elastic lash in the form of annular rubber band for swatting an insect. The swatter is in the shape of a pistol and the band is stretched along the barrel. A release means is actuated by a latch means to release the stretched rubber band toward the insect.

The references of record relied upon by the examiner as evidence of obviousness are:

Kopp	1,009,531	Nov. 21, 1911
Caron	2,054,719	Sep. 15, 1936
Watkins	2,642,057	June 16, 1953

THE REJECTIONS

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Caron in view of Kopp.

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Kopp in view of Caron.¹

Claims 7 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Caron in view of Kopp and further in view of Watkins.

Claims 7 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Kopp in view of Caron and further in view of Watkins.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the conclusion that the applied prior art establishes a *prima facie* case of obviousness with respect to claims 1, 4 through 6 and 7 through 10 on appeal.

¹ Unlike the examiner, we do not consider the order in which prior art is applied in a rejection to be significant. See, for example, In re Bush 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961) ("[i]n a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be a matter of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of B in view of A, or to term one reference primary and the other secondary."); In re Cook, 372 F.2d 563, 152 USPQ 615 (CCPA 1967).

This *prima facie* case of obviousness has not been rebutted by additional evidence from the appellant. Accordingly, the rejections of claims 1, 4 through 6 and 7 through 10 are affirmed. The applied art does not establish the *prima facie* obviousness of claims 11 through 15. The rejection of these claims is reversed. Our reasons follow.

Appellant's first argument is that the new rejection of claims 1 and 4 through 15 is unwarranted under the doctrine of *res judicata*, or law of the case, in view of the full reversal of the same claims on evidence in the record by the prior decision of the Board. However, the predecessor to our reviewing court has previously dealt with this issue. The court stated in In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 32-33 (CCPA 1974):

Appellants' contention that the prior board decision reversing a rejection under 35 U.S.C. § 103 over Borkowski et al. in a parent application should have been "*res judicata*" to the examiner in this case is unpersuasive. This court stated in In re Craig, 411 F.2d 1333, 56 C.C.P.A. 1438 (1969), that the policy and purpose of the patent laws preclude the applicability of any doctrine akin to the judicially-developed doctrine of "*res judicata*" to bar the granting of patents on inventions that comply with the statute. The same policy and purpose precludes reliance on any such doctrine to force the granting of patents on inventions that do not comply with the statute. The Patent Office must have the flexibility to reconsider and correct prior decisions that it may find to have been in error.

Next, appellant raises the issue of a rejection based on cited prior art that was never applied in a reexamination as was the case in In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). However, it is clear, that the result in Portola was dictated by the narrow scope of reexamination afforded the PTO by the statute. In the case of an application for patent, the PTO has broad scope. The court explicitly recognized in Portola the PTO's goal of performing a thorough and conscientious examination before allowing applications to be patented. 110 F.3d at 791, 42 USPQ2d at 1300.

Turning to the rejections based on prior art, it is our finding, that Kopp discloses a toy gun in the form of an elastic lash made of an annular rubber band having a first loop joined to the distal end of an elongated rod. When the lash is released, it spontaneously contracts and may be used to strike "some object such as a fly or an insect [sic]." Kopp releases the elastic lash by way of a trigger made of a single piece of resilient material 9. Thus, Kopp differs from the claimed subject matter in having a resilient trigger 9 which does not include a latch or a means pivotally joined adjacent to the latch for releasing the lash.

It is our finding that Caron also discloses a toy gun having an elongated rod wherein an elastic member formed of an annular rubber band is placed on the end of the rod. Caron teaches releasing the lash by means of a pivoting latch member 8 which is adjacent the proximal end of the rod and which engages the second loop of the elastic band. The pivotal latch is released by a trigger which is pivotally joined to the rod and placed adjacent to the latch for selectively releasing the latch and allowing the annular rubber band to spontaneously contract and be launched off the end of the toy gun. Caron differs from the subject matter claimed in that Caron does not disclose the utility of using the elastic lash for impacting an insect. Furthermore, Caron does not disclose the elastic lash fixedly joined to the distal end of the rod. Inasmuch as Caron discloses a latch and a means comprising a trigger for selectively releasing the latch for the benefit of providing discharge parts of a toy gun with positive control and shock absorption, it would have been obvious to use the pivotal latch and the latch releasing mean of Caron on the toy gun as disclosed in Kopp.

Appellant argues that Caron and Kopp are non-analogous art. We disagree. Turning first to Kopp, the reference teaching is within appellant's field of endeavor, i.e., killing insects with

an elastic lash attached to a toy pistol handle. Furthermore, since Caron is directed to a disclosure which is concerned with releasing an elastic band, Caron is clearly reasonably pertinent to appellant's problem.

Appellant argues that there is no suggestion for the examiner's proposed combination of references. This is clearly not the case. Caron specifically discloses that his release means and his latch are provided to enable a positive acting release of the elastic band. Furthermore, Caron teaches that the provision of spring 16 on his latch means provides a shock absorbing mechanism to preclude the possibility of damage to the pistol. These are express, written suggestions of the desirability of the mechanism of Caron which would have clearly motivate one of ordinary skill to include such modifications on the pistol of Kopp.

We are further in agreement with the examiner that claims 1 and 4 through 10 do not preclude the presence of a knot on the pistol of Kopp. We further disagree with the appellant's repeated assertion that the "primary function of Kopp's toy gun is a toy gun." It seems clear that the disclosure in Kopp mentions killing insects in several locations, and Fig. 1 of the patent clearly discloses using the gun to kill an insect.

Likewise, we affirm the rejection of claims 7 through 10 based on the combined teachings of Kopp, Caron and Watkins. Watkins is cited to disclose a preferred manner of securing the rubber band to the distal portion of the elongated rod of the pistol shaped frame. Watkins uses a keyhole slot which allows ready replacement of the rubber band, but insures that the rubber band will not become easily detached under even the most violent manipulation of the gun. Following this express disclosure of Watkins, it would have been obvious to use a keyhole slot to attach the rubber band to the insect killing gun of Kopp.

Appellant argues that Watkins is not within appellant's field of endeavor. Even if this were the case, appellant has not argued that Watkins is not reasonably pertinent to the problem with which appellant is concerned. In our view, the gun of Watkins is reasonably pertinent to appellant's problem. Appellant states there is no motivation for using the feature of Watkins with the combined teachings of Caron and Kopp. As noted above, Watkins provides express, written motivation or suggestion for the examiner's proposed combination for claims 8 and 9. We agree with the examiner that the exact orientation of the keyhole slot is a design choice. We note appellant's reliance on benefits such as loose support of the lash, easy replacement

thereof, self retention upon firing, etc. The first three of these benefits are expressly disclosed in Watkins' disclosure.

With respect to claims 11 through 15, we are in agreement with the appellant that the applied prior art of Kopp, Caron and Watkins does not render obvious the provision of a thumb grip on the latch as claimed in claim 11. We are cognizant of the examiner's argument that such a thumb grip is prevalent in the art, but we are not convinced of the propriety of maintaining the rejection due to the lack of an evidentiary basis thereof. For this reason it is our conclusion of law that claims 11 through 15 would not have been obvious for the lack of any disclosure in the references of a thumb grip.


SUMMARY

Rejections of claims 1 and 4 through 10 are affirmed. The rejection of claims 11 through 15 is reversed.


Appeal No. 2000-2033
Application 08/331,851

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


WILLIAM F. PATE, III
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 2000-2033
Application 08/331,851

Francis L. Conte
6 Puritan Avenue
Swampscott, MA 01907

8/5/02

United States Court of Appeals for the Federal Circuit

02-1150

IN RE FRANCIS L. CONTE

JUDGMENT

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

in Case NO(S). 08/331,851

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

DATED JUN 5 2002

Jan Horbaly 
Jan Horbaly, Clerk

ISSUED AS A MANDATE: JULY 29, 2002

6/10/02
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**NOTICE OF ENTRY OF
JUDGMENT ACCOMPANIED BY OPINION**

OPINION FILED AND JUDGMENT ENTERED: 06/05/02

The attached opinion announcing the judgment of the court in your case was filed and judgment was entered on the date indicated above. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

No costs were taxed in this appeal.

Regarding exhibits and visual aids: Your attention is directed to FRAP 34(g) which states that the clerk may destroy or dispose of the exhibits if counsel does not reclaim them within a reasonable time after the clerk gives notice to remove them. (The clerk deems a reasonable time to be 15 days from the date the final mandate is issued.)

JAN HORBALY
Clerk

cc: FRANCIS L. CONTE
JOHN M. WHEALAN

IN RE CONTE, 02-1150
PTO - 08/331,851

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

02-1150
(Serial No. 08/331,851)

IN RE FRANCIS L. CONTE

DECIDED: June 5, 2002

Before MAYER, Chief Judge, LOURIE and LINN, Circuit Judges.

LOURIE, Circuit Judge.

DECISION

Francis L. Conte appeals from the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences affirming the rejection of claims 1 and 4-10 of U.S. Patent Application Serial No. 08/331,851 as obvious under 35 U.S.C. § 103. Ex parte Conte, Appeal No. 2000-2033, slip op. at 9 (Bd. Pat. App. & Inter. Sept. 20, 2001) (Paper No. 27) ("Conte II"). Because the Board's decision was supported by substantial evidence and is correct as a matter of law, we affirm.

DISCUSSION

Mr. Conte is the named inventor of the '851 application, which relates to an insect swatter. In one embodiment of the invention, an elastic band is stretched between the proximal and distal ends of a gun. The band contracts and swats an insect when released by a trigger mechanism. The claims on appeal read as follows:

stretching said lash by pulling said lash second loop generally parallel to said rod and adjacent to said rod proximal end;
latching said lash second loop around said latch;
gripping said handgrip to aim said rod distal end at said insect; and
pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

9. A swatter according to claim 7 wherein:

said latch extends upwardly from said handgrip; said keyhole slot is open downwardly in a direction opposite to said upward extension of said latch; and said lash is inclined upwardly from said keyhole slot to said latch when latched thereto.

10. A swatter according to claim 7 wherein:

said latch is pivotable between a cocked position wherein said latch extends generally perpendicularly to said rod for retaining said lash second loop thereon, and a fired position wherein said latch is inclined forwardly toward said rod distal end for allowing said lash second loop to slip off said latch for spontaneously contracting said lash; and

said trigger is operatively joined to said latch for releasing said latch to pivot from said cocked position thereof to said fired position thereof upon pulling said trigger.

Mr. Conte filed the '851 application on October 31, 1994. The examiner initially rejected the claims under 35 U.S.C. § 103 as being unpatentable over a combination of two references, a rejection that was later reversed by the Board. Ex parte Conte, Appeal No. 96-3971, slip op. at 4 (Bd. Pat. App. & Inter. Sept. 22, 1998) (Paper No. 11) ("Conte I"). Thereafter, the examiner rejected the claims under §§ 102 and 103 over new references, Caron and Kopp, and Watkins, which had previously been cited. In response, Conte petitioned the Director of the Patent and Trademark Office ("PTO") for mandamus to direct the examiner to allow the claims, arguing that the examiner should not have reopened prosecution of the claims under 37 C.F.R. § 1.181. The Director denied that petition. Conte then challenged the rejection on the merits at the Board, which affirmed the examiner's rejection as to the claims now on appeal, claims 1 and 4-10, but reversed as to claims 11-15. The Board determined that the rejection was not

insects, not killing them; (2) Caron relates only to toy guns, not to those that kill insects; and (3) Watkins similarly discloses no utility as an insect swatter, and its use as such would likely cause the insect to be squashed and leave an undesirable stain. On the merits, Conte asserts that the Board mischaracterized Kopp as having an annular band and a first and second loop as in claim 1. He also argues that the Board erred in concluding that it would have been obvious to combine Kopp and Caron because Caron discloses catapulting the elastic band away, whereas Kopp teaches that the band remains attached to the stock, and that a combination of those references would render them inoperable. Conte also disagrees with the Board's determination that the exact orientation of the keyhole slot of Watkins is a design choice. Finally, Conte argues that the Board did not consider objective evidence of the superiority of his invention over the prior art.

We agree with the PTO that we lack jurisdiction to consider Conte's appeal from the Director's decision denying Conte's petition concerning the examiner's action in reopening prosecution following Conte I. Our jurisdiction in appeals from the PTO is limited to appeals from the Board of Patent Appeals and Interferences under 28 U.S.C. § 1295(a)(4)(A) and decisions of the Director of the PTO or the Trademark Trial and Appeal Board with respect to trademark applications under 28 U.S.C. § 1295(a)(4)(B). As neither of those sections confers jurisdiction over Conte's appeal from the Director's decision concerning the Rule 181 petition, we must decline to consider Conte's appeal on that issue. See In re Makari, 708 F.2d 709, 711, 218 USPQ 193, 194 (Fed. Cir. 1983) ("We do not have jurisdiction to review decisions of the Commissioner on petitions.").

in the same field of endeavor as the claimed invention or at least reasonably pertinent to the problem of killing insects by swatting them with rubber bands. Kopp's teaching of "striking" an insect with an elastic band is clearly in the same field of endeavor as the claimed invention of "killing" an insect. U.S. Patent 1,009,531, col. 2, ll. 73-4. Similarly, Caron's release mechanism for a device for striking any object with a rubber band is pertinent to addressing the problem of an appropriate release mechanism for a device that strikes insects with a rubber band. U.S. Patent 2,054,719, col. 2, ll. 15-27. Watkins is also analogous art because it addresses the problem addressed in claims 7-10, viz., attaching a rubber band to a mechanical gun and discharging that rubber band in the direction of an object. U.S. Patent 2,642,057, col. 4, l. 64 to l. 20, col. 5, l. 2. We disagree with Conte's argument that Watkins is not pertinent because the insect would be squashed and result in staining if the projectile shot from the gun of Watkins were accurately directed to hit an insect. Watkins describes an embodiment that shoots rubber bands rather than small projectiles, id., and the effect of the snapping action on an insect by those rubber bands would necessarily be similar to that in the pending claims. Moreover, while squashing and staining may be undesirable, they hardly make the reference not pertinent. We therefore conclude that substantial evidence supports the Board's decision that the cited references are analogous.

We also affirm the Board's conclusion that the subject matter of claims 1 and 4-10 would have been obvious in view of those references. Kopp teaches a toy gun for striking insects. '531 patent, col. 1, ll. 14-15. It discloses a resilient band that is fastened to the end of the gun stock. Id. at col. 1, ll. 34-45. The other end of the band is provided with a knob or knot and fastened to a releasing means at the other end of

Although Watkins teaches a slot that opens upwardly rather than downwardly, as recited in Conte's claims 9 and 10, we agree with the Board that such a difference would have been a fairly insignificant design choice, as both types of slots would retain the rubber band. See In re Rice, 341 F.2d 309, 314, 144 USPQ 476, 480 (CCPA 1965) (concluding that minor differences between the prior art and a claimed device may be a matter of design choice absent evidence to the contrary).

Finally, regarding Conte's arguments that the claims are patentable in light of secondary considerations of nonobviousness, we agree with the PTO that Conte has not demonstrated by objective evidence that his invention has superior "whipping" action over the prior art. In fact, the prior art appears to teach the same action. See, e.g., '531 patent (Kopp), col. 2, ll. 59-74 (describing the action of releasing the band so that it strikes an insect while contracting to its original, unstretched position).

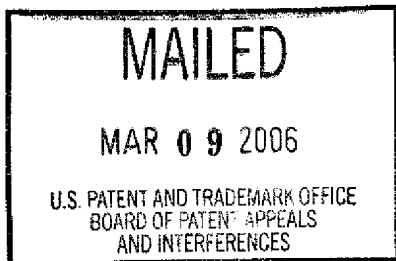
We have considered Conte's remaining arguments and find them to be unpersuasive. Accordingly, we affirm the Board's conclusion affirming the rejection of claims 1 and 4-10 as obvious under § 103.

3/13/06

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte FRANCIS LUCA CONTE

Appeal No. 2006-0635
Application No. 10/643,288

ON BRIEF

Before McQUADE, CRAWFORD, and BAHR, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Francis Luca Conte, acting pro se, appeals from the final rejection of claims 1-20, all of the claims pending in the application.

THE INVENTION

The invention relates to an insect swatter that employs an elastic lash to perform the swatting function. Representative claims 1 and 17 read as follows:

1. An insect swatter comprising:
an elongate rod having a proximal end for being hand-held,
and an opposite distal end for being aimed at an insect; and
an elastic lash including a pair of annular rubber bands
joined together at a knot therebetween, and having a proximal end

fixedly joined to said rod distal end, and an opposite distal end sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for swatting said lash distal end against said insect.

17. An insect swatter comprising:
an elongate rod having a slot at a distal end thereof;
an elastic lash configured in a figure eight with first and second knot-less loops at opposite ends, and joined together at a knot therebetween; and
said lash first loop is retained in said slot.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Kopp	1,009,531	Nov. 21, 1911
Stone	2,505,591	Apr. 25, 1950
Watkins	2,642,057	Jun. 16, 1953

THE REJECTIONS

Claims 1-4 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kopp.

Claims 5-9 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kopp in view of Watkins.

Claims 10-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kopp in view of Watkins and Stone.

Attention is directed to the main and reply briefs (filed May 5, 2005 and August 17, 2005) and the final rejection and answer (mailed December 17, 2004 and July 27, 2005) for the respective positions of the appellant and examiner regarding the merits of these rejections.¹

DISCUSSION

Kopp, the examiner's primary reference, discloses a toy gun for targeting flies or other insects. The gun comprises a handle portion 1, an elongated stock 2 extending forward from the handle portion, a resilient band 5 fastened at one end to the front of the stock by a pin or staple 4, a fixed piece 7 mounted at the back of the stock for releasably engaging the free end of the resilient band, and a resilient trigger 9 having one end portion 10 secured to the bottom of the stock, an intermediate portion 12 extending upwardly through an opening 3 in the stock and a second end portion 13 disposed adjacent the fixed piece. In use, one stretches the resilient band 5 and releasably engages its free end with the fixed piece 7, grasps the handle portion 1 with an

¹ In the final rejection, claim 17 also stood rejected under 35 U.S.C. § 112, first paragraph. Upon reconsideration, the examiner has withdrawn this rejection (see page 3 in the answer).

index finger on the trigger 9, points the gun at a fly or other insect (see Figure 1), and pulls the trigger causing its end portion 13 to disengage the resilient band from the fixed piece, whereby the free end of the band snaps forward of the gun to strike the target (see page 1, lines 59-74).

As conceded by the examiner (see page 3 in the final rejection), Kopp does not meet the limitation in independent claim 1 requiring the elastic lash to include a pair of annular rubber bands joined together at a knot therebetween, or the corresponding limitation in independent claim 17 requiring the lash to be configured in a figure eight with first and second knot-less loops at opposite ends joined together at a knot therebetween. The appellant's specification (see, for example paragraphs [0052-0071]) indicates that these features provide the lash with improved performance as compared with a simple rubber band lash. In contrast, Kopp's lash, resilient band 5, appears to be a flat strip.

The examiner deals with the admitted failure of Kopp to meet the lash limitations in claims 1 and 17 by submitting that:

Kopp shows one rubber band. However, given one rubber band, it would have been obvious to employ two for multiplied effect. See *In re Harza*, 124 USPQ 378. Further it would have been obvious to join the rubber bands

together to increase the range of the weapon
[final rejection, page 3].

In response to the appellant's criticism of this line of reasoning, the examiner further contends that

The two rubber bands would be looped together with one end connected to means 4 and the other end would be connected to fixed piece 7 by a knot or other suitable connection. The motivation of using two rubber bands rather than one is merely that at some point in use the rubber band 5 is going to break, and when it does the user, may not have a rubber band of the same length as the original. The user might have two shorter rubber bands that add together in length to that of the original rubber band. So to keep the device operational the user would have the choice of waiting to get another rubber band of the same length as the original or employ two shorter rubber bands. Hence one skilled in the art would have found it obvious to employ two or a plurality of rubber bands instead of one. A user would have contemplated both a lengthwise connection between the rubber bands and also a side by side connection of the rubber bands along one stock. Other configurations are also possible. . . . The multiplied effect is that combination when connected in a U-shaped mounting with two ends mounted to the front of the rubber band gun and the middle portion mounted to the fixed piece 7 would have a wider area of rubber being sent at the insect which is a multiplied effect [answer, page 4].

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has

the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the rather imaginative rationale advanced by the examiner to account for the acknowledged deficiencies of Kopp vis-a-vis the lash limitations in claims 1 and 17 amounts to no more than unsupported conjecture. This evidentiary flaw finds no cure in the citation of In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) for the proposition that a mere duplication of parts has no patentable significance. To begin with, the inference of such a general or per se rule of obviousness from a case turning on specific facts has no basis in law. See In re Ochiai, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1995); In re Wright, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965). Furthermore, the application of such a per se rule to reject a claim constitutes legal error because it bypasses the particularized fact-specific inquiry required by § 103(a). Id. Finally, and in any event, the underlying description of the subject lash limitations in the appellant's specification belies any notion that they embody a mere duplication of parts.


Thus, Kopp does not justify the examiner's conclusion that the differences between the subject matter recited in independent claims 1 and 17 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 17, and dependent claims 2-4, as being unpatentable over Kopp.

As the examiner's application of Watkins and/or Stone does not cure the shortcomings of Kopp relative to the subject matter recited in parent claims 1 and 17, we also shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 5-9 and 18-20 as being unpatentable over Kopp in view of Watkins, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 10-16 as being unpatentable over Kopp in view of Watkins and Stone.


SUMMARY

The decision of the examiner to reject claims 1-20 is reversed.

REVERSED


JOHN P. McQUADE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2006-0635
Application No. 10/643,288

Page 9

FRANCIS L. CONTE
6 PURITAN AVENUE
SWAMPSCOTT, MA 01907